UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,159	02/15/2000	Lalitha Vaidyanathan	1018-001US01	7527

28863   7590   10/02/2007
SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

EXAMINER
MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
3629	

MAIL DATE	DELIVERY MODE
10/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 09/504,159
Filing Date: February 15, 2000
Appellant(s): VAIDYANATHAN ET AL.

OCT 0 2 2007

GROUP 3600

Kent J. Sieffert

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 6, 2007 appealing from the Office action mailed September 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application serial number 10/672136 is a continuation of this application and an appeal brief has been filed with this application.

(3) Status of Claims

The statement of the status of claims contained in the brief is essentially correct.

Claims 1-17, 20-22, 25-31, 64-73, 93-100 and 108-117 are currently pending.

Claims 18-19, 23-24, 32-63 and 74 have been cancelled.

Claims 75-92 and 101-107 have been withdrawn.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is essentially correct. However, the Examiner will present the grounds of rejection in the

order that they appear in the Office action mailed on September 23, 2005.   The

following grounds of rejection are to be reviewed:

1.   Claims 111 and 115 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

2.   Claims 1-17, 20-22, 25-27, 64-73, 93-99, 100,109, 110-113, and 115 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Sloo (US 5,895, 450) (hereinafter

referred to as Sloo) in view of Collins et al (US 2002/0007362) (herein referred to as

Collins).

3.   Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo in

view of Slaikeu (US Patent 2001/0007106).

4.   Claims 28-31, 114, and 116-117 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Sloo and Collins as applied to claim 1 above, and further in view of

www.truste.com (retrieved from the Internet Archive Wayback Machine) (hereinafter

referred to as TRUSTe).

5. Moreover, applicant has provided arguments as to the declaration submitted under

37 CFR 1.132. The Examiner address these arguments on page 89 of the Examiner's

Answer.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,895,450	SLOO	4-1999
2002/0007362	COLLINS ET AL	1-2002
2001/0007106	SLAIKEU	6-2001

WWW.TRUSTE.COM retrieved from the Internet Archive Wayback Machine

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 111 and 115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 111 and 115 the appellant claims *wherein the online dispute resolution system and the marketplace have separate database, automatically electronically*

communicating transaction data between the database of the online dispute resolution

system and the database of the electronic marketplace; wherein the online dispute

resolution system comprises a data manager software application *to automatically*

communicate data between the database of the online dispute resolution system and

the database of the electronic marketplace.

The Examiner is unable to find support for the italicized portions of the claim

language in the original disclosure. Therefore, the Examiner request that the appellant

specifically direct the Examiner to the portions of the specification where there is

support for this claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17, 20-22, 25-27, 64-73, 93-99, 100,109, 110-113, and 115 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Sloo (US 5,895, 450) (hereinafter

referred to as Sloo) in view of Collins et al (US 2002/0007362) (herein referred to as

Collins).

Referring to Claim 1:

Sloo discloses a method and a system for resolving a commerce dispute

involving one or more parties (a *complaint handling apparatus (Figure 1))* for resolving

complaints related to goods, class of goods, services, and/or venders, the subjects of

the complaints may be manufacturers, distributors, wholesalers, retailers or any other

responsible persons or entities (col. 3, lines 1-8) *with a plurality of access terminals* (col.

3, lines 8-11), comprising:

electronically providing access to an online dispute resolution system to allow at

least one of the parties to initiate a filing of the dispute from a marketplace (Figs. 1-6,

col. 2, line 53 thru col. 3, line 7 - *the complaint handling apparatus 10 broadly includes a*

central computer 12 and a plurality of access terminals coupled with the central

computer by a communication network 16; (col. 3, lines 8-39) (electronically providing

access to an online dispute system); *the access terminals receive complaints and*

responses from the users (col. 3, lines 18-20) (to allow one of the parties to initiate a

filing of a dispute); *the users of the apparatus who file complaints may include*

individuals, businesses, organizations or other entities and the complaints may relate to

goods, classes of goods, services, and/or vendors, individuals, organizations or any

object, the subject of the complaint may be individuals, manufacturers, distributors,

wholesalers, retailers) (col. 3, lines 1-8) (wherein the dispute may be filed from a

marketplace) (*retailer, wholesaler, complaints relating goods and services;* col. 17, line

66 thru col. 18, line 16 *consumer complaint module);*

electronically receiving with the online dispute resolution system transaction data

from the marketplace, wherein the transaction data describes transactions within the

marketplace (the Examiner interprets "electronically receiving data" to include data

entered manually and transmitted through a communication network - Figs. 3-9; col. 2,

lines 7-20 - *receiving complaints and responses over the communication network* (col.

3, lines 18-20) (electronically receiving with the online dispute resolution system

transaction data *(responses), the users of the apparatus who file complaints may*

include individuals, businesses, organizations or other entities and the complaints may

relate to goods, classes of goods, services, and/or vendors, individuals, organizations or

any object, the subject of the complaint may be individuals, manufacturers, distributors,

wholesalers, retailers (from a marketplace) wherein *the apparatus receives complaints,*

notifies the subject of the complaints, receives responses from the subject (transaction

data from the marketplace), *stores the complaints and associated responses in*

individual data records (col. 2, lines 56-59); see also, col. 2, lines 56-59; see Figure

(500) and discussion as to Figure 5 (column 5, line 66 through column 6, line 14 and

col. 6, lines 55-60) – *this portion of the program permits a subject to respond to a*

complaint issued against it. The subject may respond to the complaint by entering

information in one of the access terminals and e-mailing or transmitting the information

to the central computer by way of the communication network) (responses to the

complaints are received – see Figure 5 (500). (The Examiner is interpreting a response

to a complaint from a retailer via the complaint handling apparatus as transaction data

being received from the marketplace. Electronically receiving transaction data would

include data entered manually into a computer and would include any communication

over the network*);*

receiving from at least one of the parties information *(complaint)* related to the

dispute (col. 2, lines 53-65; col. 3, lines 19-29 *the access terminals 14 receive*

complaints and responses from the user, deliver them to the central computer 12

(column 2, lines 56-57, column 3, lines 19-29); and

executing software with the online dispute resolution system (artificial intelligence

(e.g. neural network linking)) to apply an online dispute resolution process that utilizes

at least a portion of the transaction data and the information to assist the parties in

resolving the dispute (col. 3, lines 8-67 - *each access terminal includes conventional*

memory and software for communicating with and interpreting the data sent from the

central computer (col. 3, lines 8-67); col. 1, line 66 thru col. 2, line 6 *the central*

computer is programmed to receive complaints and responses, store the complaints

and responses in individual data records, and negotiate settlements to the complaints;

col. 2, lines 12-20 and Figure 9 - *the central computer is programmed to monitor and*

rate the conduct and performance of both the complainants and the subjects; the ratings

can be used to affect the outcome of the disputes and hold the parties accountable for

their conduct; col. 9, line 40 through col. 10, line 39 *when the program uses artificial*

intelligent techniques to make a decision regarding a dispute, it considers the

performance records of all participants to the dispute when rendering a judgment; the

program evaluates all of the gathered information to arrive at a judgment; the program

may compare the characteristics from the current data record with the characteristics

from the data records for the previously resolved complaints to arrive at an appropriate

judgment; col. 10, lines 58-61 *by monitoring participant behavior in certain situations*

and outcomes over time the program may compare the current situation with other

similar situations having known outcomes and predict the outcome for the present

situation based on known outcomes. Artificial intelligence techniques may be used to predict an outcome based on what it has learned about behavior, situations and their outcomes. Thus, the program may suggest the best behavior to a user).

Although Sloo discloses that the complaints may relate to goods, classes of goods, services, and/or the vendors (col. 3, lines 2-7) and transaction data (col. 9, lines 57-63), Sloo does not disclose that the marketplace is an electronic marketplace or that the process utilizes at least a portion of the transaction data from the marketplace in resolving the dispute.

However, Collins discloses an electronic marketplace ([0039] *a customer may have a dispute with a merchant. The dispute may arise in connection with a transaction occurring over the Internet)* and that the process utilizes at least a portion of the transaction data from the marketplace in resolving the dispute ([0042] *each party sends position data over the network to central server 120; the relational database associates the data from each party to components in the database to form the ZOPA (zone of possible agreement) template).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the electronic marketplace and marketplace data with the complaint handling method and system of Sloo so as to facilitate agreements in disputes involving transactions occurring over the Internet between a merchant and a consumer.

Referring to Claim 112:

Sloo discloses a system that electronically receives transaction data from a

marketplace Figs. 3-9; col. 2, lines 7-20 - *receiving complaints and responses over the*

communication network (col. 3, lines 18-20) (electronically receiving with the online

dispute resolution system transaction data (*responses*), *the users of the apparatus who*

file complaints may include individuals, businesses, organizations or other entities and

the complaints may relate to goods, classes of goods, services, and/or vendors,

individuals, organizations or any object, the subject of the complaint may be individuals,

*manufacturers, distributors, wholesalers, retailers (*from a marketplace) wherein *the*

apparatus receives complaints, notifies the subject of the complaints, receives

responses from the subject (transaction data from the marketplace), *stores the*

complaints and associated responses in individual data records (col. 2, lines 56-59); see

also, col. 2, lines 56-59; see Figure (500) and discussion as to Figure 5 (column 5, line

66 through column 6, line 14 and col. 6, lines 55-60) – *this portion of the program*

permits a subject to respond to a complaint issued against it. The subject may respond

to the complaint by entering information in one of the access terminals and e-mailing or

transmitting the information to the central computer by way of the communication

network) *(responses to the complaints are received – see Figure 5 (500).* (the

Examiner is interpreting that a response to a complaint from a retailer via the complaint

handling apparatus as transaction data being received from the market place.

Electronically receiving transaction data would include data entered manually into a

computer and would include any communication over the network);

wherein the system executes software that utilizes the transaction data and

applies a dispute resolution process (col. 3, lines 8-67 - *each access terminal includes*

conventional memory and software for communicating with and interpreting the data

sent from the central computer (col. 3, lines 8-67); col. 1, line 66 thru col. 2, line 6 *the*

central computer is programmed to receive complaints and responses, store the

complaints and responses in individual data records, and negotiate settlements to the

complaints; col. 2, lines 12-20 and Figure 9 - *the central computer is programmed to*

monitor and rate the conduct and performance of both the complainants and the

subjects; the ratings can be used to affect the outcome of the disputes and hold the

parties accountable for their conduct; col. 9, line 40 through col. 10, line 39 *when the*

program uses artificial intelligent techniques to make a decision regarding a dispute, it

considers the performance records of all participants to the dispute when rendering a

judgment; the program evaluates all of the gathered information to arrive at a judgment;

the program may compare the characteristics from the current data record with the

characteristics from the data records for the previously resolved complaints to arrive at

an appropriate judgment; col. 10, lines 58-61 *by monitoring participant behavior in*

certain situations and outcomes over time the program may compare the current

situation with other similar situations having known outcomes and predict the outcome

for the present situation based on known outcomes. Artificial intelligence techniques

may be used to predict an outcome based on what it has learned about behavior,

situations and their outcomes. Thus, the program may suggest the best behavior to a

user)

wherein the system electronically provides status data based on the participation

of the parties (col. 2, lines 7-12 *the central computer is programmed to provide public*

access to the data records to permit viewing of the corresponding complaints,

responses, and settlements for allowing other users to gauge the conduct of the subject;

col. 6, lines 24-32 *the monitoring information is stored in the subject's performance*

record and used to rate the subject's conduct; Figure 9 Monitor Compliance (900);

update performance records (908); col. 11, line 44 thru col. 12, line 14).

Although Sloo discloses that the complaints may relate to goods, classes of

goods, services, and/or the vendors (col. 3, lines 2-7) and transaction data (col. 9, lines

57-63), Sloo does not disclose that the marketplace is an electronic marketplace or that

the process utilizes at least a portion of the transaction data from the marketplace in

resolving the dispute.

However, Collins discloses an electronic marketplace ([0039] *a customer may*

have a dispute with a merchant. The dispute may arise in connection with a transaction

occurring over the Internet) and that the process utilizes at least a portion of the

transaction data from the marketplace in resolving the dispute ([0042] *each party sends*

position data over the network to central server 120; the relational database associates

the data from each party to components in the database to form the ZOPA template).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the electronic marketplace and marketplace data with the

complaint handling method and system of Sloo so as to facilitate agreements in

disputes involving transactions occurring over the Internet between a merchant and a consumer.

The language defining the marketplace as a web-based community having buyers and sellers of goods and services is an attempt to define a system by a characteristic rather than by its specific structure. Collins identifies a system for facilitating agreement between a customer and a merchant wherein the transaction may have occurred over the Internet ([0039]). Therefore, the Examiner has reason to believe that the systems of Collins and Sloo would be capable of resolving disputes over a marketplace defined as a web-based community having buyers and sellers of goods and services.

The type of data being transmitted in considered to be non-functional descriptive data not interrelated with the useful structure of the system and thus will not serve as a limitation. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, sees *In re Gulack,* 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Furthermore, the recited statement of intended use of the system, to assist the buyers or sellers in resolving disputes relating to the transactions, does not patentably distinguish the claimed invention.

Referring to Claim 2 and 64:

Sloo discloses a method and system for complaint handling (*resolving disputes; page 2 lines 54-56*) over a complaint handling apparatus which includes a computer

(Figure 1 and page 3, lines 8-30) wherein there are at least two modes (Figure 7), the

first mode requiring the online dispute resolution process to be driven by an electronic

agent (col. 7, lines 29-40 *Automatic Negotiator which allows the apparatus to determine*

a resolution to the dispute and a second mode involving a human dispute resolution

specialist (Judge/Jury Figure 7 (712)) (the system comprising a database (*col. 3, lines*

8-17; col. 20, lines 25-26 storing means for storing) and server that receives information

and compares the information (col. 20, lines 57-58 *comparing means for comparing said*

data) comprising automatically selecting one of two modes of resolving the dispute

(Figure 7), the first mode requiring the online dispute resolution process being driven by

an electronic agent to assist the parties in resolving the dispute (Automatic Negotiator

(Figure 7 (702) and the second mode involving a human dispute resolution specialist

(Figure 7 (712) Judge/Jury).

Referring to Claim 3:

Sloo discloses a method wherein the case-based reasoning system contains a

history file (*Fig. 2 (206-216), col. 1, line 66 thru col. 6 data records; col. 9, lines 32-48*

when the program uses artificial intelligent techniques to make a decision regarding a

dispute, it considers the performance records of all participants to the dispute when

rendering a judgment).

Referring to Claim 4:

Sloo discloses a method and system wherein the history file contains patterns

and precedents, further comprising applying the patterns and precedents to generate

an outcome prediction (col. 10, line 54 thru col. 11, line 2 - *By monitoring participant*

behavior in certain situations and outcomes (complaint activity or measurable

satisfaction levels) over time, the program may compare the current situation with other

similar situations having known outcomes and predict the outcome for the present

situation based on these known outcomes. Artificial intelligence techniques may be

used to predict an outcome based on what it has learned about behavior, situations

and their outcomes. Thus, the program may suggest the best behavior to the user to

reduce the number of complaints by providing guidelines for appropriate behavior

before a dispute arises).

Referring to Claim 5:

Sloo discloses a method further comprising presenting the outcome prediction to

the parties to assist the parties in selecting the mode of resolving the dispute (*col. 10,*

line 54 thru col. 11, line 2, col. 11, lines 21-36 the program then retrieves data records

from previously resolved complaints in step 804 to

evaluate the information entered in step 802 to arrive at a proposed solution

to the current question or dispute. For example, the program may compare the

characteristics from the current question or dispute with the characteristics

from the data records for the previously resolved complaints to arrive at an

appropriate solution. Over time, the apparatus and program will accumulate a

large number of data records that can be used to accurately predict a solution

for almost any type of complaint or dispute. The program then transmits or

allows the user to view the proposed solution in step 806, col. 14, lines 33-44, Fig. 2).

Referring to Claim 6:

Sloo discloses a method wherein the outcome prediction includes one or more
likely outcomes and associated probabilities of occurrence (col. 10, line 54 thru col. 11,
line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 7:

Sloo discloses a method further comprising receiving settlement position from
the parties (*col. 2, lines 53-65, col. 4, lines 63-65 the program preferably prompts the
user or complainant to enter a detailed complaint, the action the user requests to
resolve the complaint or dispute, col. 7, line 66 thru col. 8, line 4 the program may allow
the complainant to establish a settlement*).

Referring to Claim 8:

Sloo discloses a method system further comprising automatically settling the
dispute if the settlement positions satisfy a predetermined criteria (Automatic Negotiator
– col. 10, lines 35-39).

Referring to Claim 9:

Sloo discloses a method wherein the predetermined criteria relates to a monetary
settlement position (*col. 7, line 66 thru col. 8, line 4 settlement (possibly a monetary
value or a contract condition)*).

Referring to Claim 10:

Sloo discloses a method wherein the predetermined criteria relates to non-
monetary settlement position (col. 7, line 66 thru col. 8, line 4 *contract condition*).

Referring to Claim 11:

Collins discloses the dispute resolution specialist resolves the dispute by transitioning from mediation stage to an arbitration stage (Figures 8a-8c; [0009] *if the mediation session does not produce an agreement, an arbiter is provided with the transcript*).

Referring to Claim 12:

Sloo discloses a method wherein the dispute resolution specialist generates a final recommended resolution (Fig. 7 (720) receive and store judgment; col. 8, lines 5-49 – *issue their judgment*).

Referring to Claim 13:

Sloo discloses a method wherein the final recommended resolution is accepted by the one or more parties (col. 9, lines 50-52, col. 11, lines 37-42 a judgment was rendered that required the subject to reimburse the complainant for damaged merchandise and the subject filed to comply (implies an acceptance of the reimbursement).

Referring to Claim 14:

Collins discloses creating a contract between the one or more parties stating a willingness to abide by the recommended resolution (Figures 7a-7b).

Referring to Claim 15:

Sloo discloses a method further comprising communication among the parties using a plurality of communication modes (Fig. 2, communication network, col. 3, lines

31-39 *local area network, wide are network, wireless network, voice network*; col. 6,

lines 55-67 mail or fax).

Referring to Claim 16:

Sloo discloses a method wherein the communication modes include a public

messaging mode and a private messaging mode (Figs. 2, 7, col. 2, lines 7-9 *central*

computer is programmed to provide public access to data record; col. 3, lines 30-38 *the*

private communications transmitted over the communication network may be encrypted

or otherwise protected using available technology).

Referring to 17:

Sloo discloses a method wherein the communication mode is selected by the

dispute resolution specialist (col. 4, lines 1-8 and 45-60; col. 6, lines 55-64; col. 4, line

61 thru col. 5, line 2). It is inherent that the mode of communication can be selected by

the system or the users which would include the dispute resolution specialist.

Referring to Claims 20-21:

Sloo discloses a method further comprising providing visual cues when applying

the dispute resolution process to automatically highlight agreements between the

parties (col. 13, lines 5-40 *apparatus may create warnings or bulletins on objects based*

on what it knows about the participants; col. 13, line 59 thru col. 14, line 16).

Referring to Claim 22:

Sloo discloses a method further comprising storing status data on participation of

the parties in the dispute resolution process (col. 2, lines 7-20, col. 6, lines 24-32 *the*

program may monitor how long it takes the subject to respond to the notification. This

monitoring information is stored in the subject's performance record; col. 8, lines 50-58
program updates both the complainant's and subject's performance record, col. 10,
lines 54-64; col. 11, lines 37-43 Monitor Compliance; col. 17, line 66 thru col. 18, line
15).

Referring to Claim 25:

Sloo discloses a method wherein the data relates to compliance of a participant
to a result of the resolution of the dispute (col. 2, lines 7-20, col. 10, lines 53-64; col. 11,
line 38 thru col. 12. line 14 Monitor Compliance).

Referring to Claim 26:

Sloo discloses a method further comprising communicating the status data from
the dispute resolution system to the marketplace and highlighting an offender based on
the status information (col. *11, lines 38 thru col. 12, line 5 judgment rendered that
required the subject to reimburse the complainant for damaged merchandise and the
subject failed to comply; if program determines one of the parties in fact failed to comply
with a term or condition of a judgment, it updates the appropriate data record to indicate
the compliance failure and posts the information in the public record; col. 12, line 47 thru
col. 13, line 24, col. 17, line 66 thru col. 18, line 14*).

Referring to Claim 27:

Sloo discloses a method further comprising providing a system for assigning the
dispute resolution specialist to a particular dispute (*col. 8, lines 5-19 the program then
selects the judge or jury form a list of pre-qualified persons; preferably, these pre-
qualified persons are categorized by criteria*).

Referring to Claim 72:

Sloo discloses a method further comprising determining a current mode of resolving the dispute; and automatically selecting a communication mode based on the determination (col. 6, lines 55-68; col. 10, line 54 thru col. 11, line 36).

Referring to Claim 73:

Sloo discloses a method further comprising providing the data to the parties to assist the resolution dispute (col. 4, line 61 thru col. 5, line 2 *program prompts user to enter his or her complaint; the program prompts user or complainant to enter a detailed complaint, the action the user requests to resolve the complaint or dispute, an abbreviated description of the complaint*; col. 10, line 54 thru col. 11, line 5; col. 11, lines 27-36 *the program may suggest the best behavior to the user; the program allows the user to view the proposed solution*)

Referring to Claim 100:

Sloo discloses a method further comprising maintaining a database that stores facts and outcome of previously resolved electronic commerce disputes (data records) (col. 2, lines 7-20; col. 5, lines 3-10, and 56-65; col. 15, lines 46-58), and wherein executing software apply a case-based reasoning system (col. 3, lines 8-30 and 45-53) comprises:

searching the database to identify previously resolved disputes with facts that are similar to the case information (col. 4, lines 14-17, col. 10, lines 13-22 col. 10, line 54 thru col. 11, line 2 *the program compares the current situation with other similar situations having known outcomes*);

identifying at least one likely outcome of the dispute based on the outcomes of

the identified previously resolved disputes (col. 10, line 54 thru col. 11, line 5 *predicts*

the outcome of the present situation based on the known outcome); and

presenting the identified likely outcomes to the parties as a potential resolution to

the dispute to assist the parties in negotiating a resolution to the dispute (col. 10, line

54 thru col. 11, line 5, col. 11, lines 27-36 *predicts the outcome of the present situation*

based on the known outcome; suggest the best behavior to the user).

Referring to Claim 109:

. Sloo discloses a method further comprising applying a case-based reasoning

system to the information to produce a result for use in selection of a mode of resolving

the dispute in accordance with an online dispute resolution process (col. 11, lines 21-36

over time the apparatus and program will accumulate a large number of data records

and can be used to accurately predict a solution for almost any type of complaint or

dispute; the program transmits or allows the user to view proposed solution; col. 14,

lines 32-44).

Referring to Claim 65:

Sloo discloses a system wherein the server searches the database to identify

previously resolved disputes with facts that are similar to the case information (col. 2,

lines 7-20, lines 53-65, col. 4, lines 9-17, col. 10, lines 58-66; col. 10, line 54 thru col.

11, line 35 *the program compares the current situation with other similar situations*

having known outcomes).

Referring to Claim 66:

Sloo discloses a system wherein the server presents the result of the comparison

by presenting the outcomes of identified previously resolved disputes (col. 10, line 58

thru col. 11, line 35 *predicts the outcome of the present situation based on the known*

outcome; suggest the best behavior to the user; program transmits or allows the user to

view the proposed solution).

Referring to Claim 67:

Sloo discloses a system wherein the server summarizes the outcome of

identified previously resolved disputes (col. 1, line 66 thru col. 2, line 12 *complaints and*

responses are stored in individual data records; settlements and judgments are stored

along with their respective complaints and responses in the data record; col. 10, line 58

thru col. 11, line 36; col. 14, lines 45-60).

Referring to Claim 68:

Sloo discloses a system wherein the server presents the result of the comparison

by generating an outcome prediction as a function of the facts and outcomes of the

identified disputes, and presenting the outcome prediction to the parties (col. 10, line 54

thru col. 11, line 36 *the program compares the current situation with other similar*

situations having known outcomes and predicts the outcome of the present situation;

program transmits or allows the user to view the proposed solution, col. 12, line 47 thru

col. 13, line 23).

Referring to Claim 69:

Sloo discloses a system wherein the outcome prediction includes at least one likely outcome (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 70:

Sloo discloses a system wherein the outcome prediction includes associated probabilities of occurrence of the at least one likely outcome (col. 10, lines 13- 34 *the program may employ artificial intelligence processing with neural networks, fuzzy logic and/or genetic algorithms to analyze various scenarios using the gathered information; program may render further decisions based on collected data in a way that will most likely result in positive effects on society;* col. 10, line 54 thru col. 11, line 36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 71:

Sloo discloses a system wherein the server presents the at least one likely outcome to the parties as a potential resolution of the dispute (col. 10, line 54 thru col. 11, line 36 *program then transmits or allows the user to view the proposed solution;* col. 12, line 47 thru col. 13, line 23, col. 14, lines 33-34).

Referring to Claim 93:

Collins discloses automatically select a resolution mode comprising one of (i) a direct negotiation mode that allows the parties to directly negotiate a resolution to the dispute via the computer network (Figure 8a (820), 8b (820)) , (ii) a conciliation mode that allows the parties to negotiate the resolution to the dispute through a mediator

(Figure 8a (830) 8b (830)), and (iii) mediation mode that allows a mediator to propose a resolution to the dispute ([0045] *the second and third levels involve interaction with a live third party for resolving the conflict*).

Referring to Claim 94:

Sloo discloses a system wherein the server provides a preprogrammed recommended resolution to at least one of the parties based on the comparison (col. 2, lines 53-65, col. 10 line 54 thru col. 11, line 35, Automatic Decision Maker).

Referring to Claim 95:

Sloo discloses a system wherein the server:

performs an analysis of the dispute and presents pre-programmed recommended resolutions based on the analysis in the first mode (col. 10, line 54 thru col. 11, line 35 *the program compares the current situation with other similar situations having known outcomes; program then transmits or allows the user to view the proposed solution*);

performs a match of needs of the two parties as defined by the dispute to resolve the dispute in a second mode (col. 4, lines 14-17 *the program uses the information entered to search the memory of the central computer to find a subject or subjects that match the search data*);

providing a medium for the parties to independently resolve the dispute in a third mode (col. 4, lines 19-37, col. 5, line 66 thru col. 6, line 32; col. 6, line 55 thru col. 7, line 26 *the subject may respond to the complaint by entering information in one of the access terminals*); and

assigns a dispute resolution specialist to resolve the dispute in a fourth mode
(col. 8, lines 5-18 *program selects a judge or a jury*).

Referring to Claim 96:

Collins discloses a system wherein the server provides a message exchange by
which the dispute resolution specialist interacts with the parties to reach a
recommended resolution (Figure 8a –8c; [0009] and [0045] *interaction with a live third
party for resolving conflict*).

Referring to Claim 97:

Sloo further discloses a system wherein the server automatically assigns the
dispute resolution specialists (col. 8, lines 5-20 *program selects a judge or a jury*).

Referring to Claim 98:

Sloo discloses a system further comprising a software program executing on the
server to automatically assemble the case information from records provided by the
parties, wherein the software module presents sample resolutions to the parties to aid
the parties in resolving the case and presents the case information in a form that
identifies areas of agreement between the parties (Fig. 1, col. 10, line 54 thru col. col.
11, line 36 *program may suggest the best behavior to the user to reduce the number of
complaints by providing guidelines for appropriate behavior before a dispute arises*).

Referring to Claim 99:

Sloo discloses a system further comprising:

a software program operating the server to assemble the case information from

records provided by the parties (col. 1, line 66 thru col. 2, line 6; col. 3, lines 18-29; col.

4, line 59 thru col. 5, line 2); and

a software program operating on the server to assist a dispute resolution

specialist in identifying similar cases from a historical database of past cases (col. 8,

lines 5-18; col. 9, lines 32-48; col. 12, lines 25-45).

Referring to Claims 110 and 113:

Collins discloses electronically receiving with the online dispute resolution system

enrollment requests from the marketplace and automatically initiating enrollment of

sellers or buyers in response to the request ([0046-0047].

Referring to Claims 111 and 115:

Collins discloses a method and system with an online dispute resolution system

(Figure 1a ZOPA database (140)) and marketplace ([0039] *customer may have a*

dispute with a merchant regarding a transaction occurring over the Internet), the method

and system further comprising:

automatically electronically communicating the transaction data between the

database on the online dispute resolution system and the electronic marketplace ([0039]

and [0042].

while Collins discloses the online dispute resolution system having a database

(Figure 1a ZOPA database (140)) neither Collins nor Sloo explicitly disclose a

marketplace database.

However, it would have been obvious to one of ordinary skill in the art at the time

of the invention to incorporate into the complaint handling systems of Sloo and Collins a

marketplace with a database so as to provide the marketplace with maintain transaction

data concerning customers and transaction.

NOTE: Appellant is directed a recent CAFC decision, *Collegenet, Inc. v.*

Applyyourself, Inc. (CAFC, 04-1202-1222, 1251, 8/2/2005) wherein the court held that

"automatically" means "without human interaction, but may be human initiated or

interrupted." Therefore, a process may be automatic even though a human initiates it.

Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo in

view of Slaikeu (US Patent 2001/0007106).

Referring to Claim 108:

Sloo discloses intervention by pre-qualified persons (judge/jury)(col. 8, lines 5-

18)

Sloo does not a method further comprising:

training a dispute resolution specialist by requiring the dispute resolution

specialist to experience transactions within online marketplaces including at least an

auction site;

outputting simulated online dispute resolution cases to the dispute resolution

specialists via the computer network to assess the skill of the dispute resolution

specialists; and

assigning online disputes to the dispute resolution specialists only upon

completion of the training and successful resolution of the simulated online dispute

resolution cases.

However, Slaikeu discloses a method comprising training a dispute resolution

specialist (page 3 [0025- 0026]).

Furthermore, the Examiner takes Official Notice that online training is old and

well known and has become an established business practice as is exampled by online

CLE classes online graduate classes and testing. Furthermore, providing simulations of

situations is also an old and well known way to train.

Claims 28-31, 114, and 116-117 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Sloo and Collins as applied to claim 1 above, and further in view of

www.truste.com (retrieved from the Internet Archive Wayback Machine) (hereinafter

referred to as TRUSTe).

Referring to Claim 28:

Neither Sloo nor Collins disclose the dispute resolution is provided as an

insurance covering a transaction.

However, TRUSTe disclose the dispute resolution is provided as an insurance

covering a transaction (page 10 the TRUSTe program is backed by a multi-faceted

assurance process that establishes Web site credibility, thereby making users more

comfortable when making online purchases or providing information; page 19 the

Watchdog page to provide you with a convenient mechanism for reporting violations;

page 25; page 34 Resolution Process; page 50, Watchdog dispute resolution form – if

you have an unresolved dispute with a TRUSTe member).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the assurance/insurance of TRUSTe with the complaint handling

of Sloo and Collins to build users' trust and confidence in transacting over the Internet

and to provide a convenient mechanism for reporting violations and resolving disputes.

Referring to Claim 29:

TRUSTe discloses sellers associated with the marketplace being registered

subscribers of the system before transactions are insured (*page 14 in joining the*

TRUSTe online seal program, you leading the way; the trustmark is awarded only to

sites that adhere to our established privacy principles and agree to comply with ongoing

*TRUSTe oversight and **our resolution process**; page 21 Watchdog (File a Complaint);*

pages 32 – 34)

Referring to Claim 30:

TRUSTe discloses communicating membership data from the online dispute

resolution to the marketplace (page 32-34 member directory); and

automatically showing a visual indicia within the marketplace to indicate the

availability of the dispute resolution system and the membership of buyers or sellers in

the dispute resolution process (pages 14 TRUSTe "trustmark," an online branded seal;

19 and 23 Our "Seal of Trust" and Assurance Process; the site agrees to display the

trustmark).

Referring to Claim 31:

TRUSTe discloses where the visual indicia is a medallion that is a visible symbol of trust to increase the confidence of the buyers or the sellers in executing transactions within the marketplace (pages 12-14, page 23).

Referring to Claim 114:

TRUSTe discloses a membership database that maintains status data for the parties (page 32 the official TRUSTe member directory)

Referring to Claims 116 and 117:

Collins discloses a system wherein the dispute resolution system and the marketplace are implemented at least in part as software executing on a computer system having data storage devices and wherein the dispute resolution system and the marketplace communicate via the computer system ([0039] and [0042]).

(10) Response to Argument

The first ground of rejection to be reviewed on appeal – the rejection of Claims 111 and 115 under 35 USC 112, 1st paragraph

Appellant'sarguments as to this ground of rejection can be found on pages 39 through 42 of the Appeal Brief.

Appellant added claims 111 and 115 in an amendment submitted on April 12, 2004. The Examiner asserts that the subject matter of claims 111 and 115 was not clearly defined in the appellant'soriginal disclosure as filed in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Appellant states, on page 39 of the Appeal Brief, that to satisfy the written

description requirement, a patent specification must describe the claimed invention in

sufficient detail that one skilled in the art can *reasonably conclude* that the inventor had

possession of the invention. The appellant states that with respect to newly added

claim, i.e., claims not found in the original disclosure, claim limitations can be satisfied

through express, implicit or inherent disclosure.   However, the Examiner disagrees

with the assertion that the specification describes the claimed invention in sufficient

detail so that one skilled in the art can *reasonably conclude* that the inventor had

possession of the claimed invention.   Since the claim limitations are not expressly

disclosed, appellant is asking the Examiner to rely on implicit or inherent disclosure to

satisfy the written description requirement for what appellant considers to be the novel,

and thus patentably distinct, feature of an invention. Appellant is arguing that limitations

are implicit or inherent in appellant's disclosure but appellant does not give the same

implicit or inherent consideration to the prior art.

Claim 111 reads, the method of claim 1,

wherein the online dispute resolution system and the marketplace have separate

databases, and

automatically electronically communicating the transaction data between the

database of the online dispute resolution system and the database of the electronic

marketplace.

Claim 115 reads, the system of claim 112,

wherein the online dispute resolution system and the marketplace have separate

databases, and

wherein the online dispute resolution system comprises a data manager software

application to automatically communicate data between the database of the online

dispute resolution system and the database of the electronic marketplace.

The appellant asserts that the support for the elements in claims 111 and 115 are

found throughout the present application. Appellant states that as a starting point,

Figure 1 shows a marketplace 102 separate from dispute resolution system 130. The

appellant states that Figure 2B shows an embodiment 150 of the dispute resolution

system in which the dispute resolution system integrates with a business partner's

system, such as the online marketplace 102.

The appellant states that support for the limitations can be found on pages 13

and 14 of application's application, wherein appellant recites the following paragraphs:

> The server 158 receives data from a set of remote objects that reside in
> the partner's system 166. The remote objects, which can be enterprise Java
> Beans, are provided to allow business partners of the system to integrate with
> the dispute resolution system. Both DCOM objects and Enterprise Java Beans
> models can be used. These objects provide functionality to receive and send
> specific information to the dispute resolution system 130. The objects will
> transparently deal with communication issues including server unavailability and
> performance. Example functionality includes informing the dispute resolution
> system 130 of relevant partner transactions and allowing partners to query the
> dispute resolution system data such as the status of a specific marketplace seller
> 104.

> The server 158 in turn communicates with a structured query language
> (SQL) server 160. The SQL server 160 also communicates with a data manager
> 162. **The data manager 162 in turn communicates with one or more partner
> databases 164.** Partners integrate with the system, by exposing relevant

functionality on their respective websites, for example, allowing customers to dispute a transaction. This integration is achieved by a predefined set of URLs that a partner embeds in the partner's HTML application.

Appellant states, on page 8 of the Appeal Brief, that disclosure for these limitations are found in Figure 2. Appellant asserts on page 8 that:

> the step of automatically electronically communicating the transaction data (see partner data 164 of FIG. 2) between a database of the online dispute resolution system (see database server 160 of dispute resolution system 150 of FIG. 2) and a database of the electronic marketplace (zee partner database 164 of FIG. 2).

The appellant contends that the present application provides adequate support for the claim limitation that *the online dispute resolution system and the marketplace have separate databases.* Appellant states, pages 41 and 42 of the Appeal Brief, that as demonstrated above, Figure 2B and the related disclosure describe online dispute resolution system 150 as having a SQL database 160 and partner systems, **such as market place 102, as having partner databases.**

The Examiner disagrees with this interpretation. It appears that appellant is trying to equate partner databases with the marketplace and thus infer that the marketplace has its own database. As shown in Figure 1 and identified by the applicant, the marketplace is separate from the seller and the dispute resolution system and the parties. Nowhere in appellant's disclosure does the specification disclose the marketplace as having a separate database.

Appellant's specification identifies Figure 1 as (pages 11 and 12 of the specification):

FIG. 1 shows an environment 100 that supports electronic dispute resolution. In this environment, one or more sellers 104 offer their products and/or services to one or more consumers 106 at a marketplace 102. **The marketplace 106 can be a physical mall or market or can be a website such as an online centralized trading place.** The centralized trading place overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions. Through such a trading place, buyers can access a significantly broader selection of goods to purchase and sellers have the opportunity to sell their goods efficiently to a broader base of buyers.

One exemplary person-to-person trading place on the Internet is eBay, located at www.eBay.com. eBay is a Web-based community in which buyers and sellers are brought together in an efficient auction format to buy and sell items such as antiques, coins, collectibles, computers, memorabilia, stamps and toys. The eBay service permits sellers to list items for sale, buyers to bid on items of interest and all users to browse through listed items in a fully-automated, topically-arranged online service that is available 24 hours a day, seven days a week.

The seller 104 may be a manufacturer. The marketplace 102 and the seller 104 can communicate directly with each other, or can communicate over a network 120. The network 120 can be a wide area network such as the Internet. The one or more consumers 106 can communicate with the marketplace 102 and indirectly the seller 104 over the network 120. A multiparty community 110 having a first party 112, a second party 114 and an nth party 116 can communicate with the network 120. Further, the first party 112, second party 114 and nth party 116 can communicate directly with each other.

Also connected to the network 120 is a dispute resolution system 130, which is detailed below. The dispute resolution system 130 can communicate directly with a network having one or more dispute resolution specialists 140. Alternatively, the dispute resolution specialists 140 can access the dispute resolution system 130 using the network 120.

The dispute resolution specialist can be a person who is trained in the art of conducting dispute resolution, including but not limited to mediation and arbitration. The dispute resolution specialist can also be a person who has had substantial experience mediating or arbitrating a range of disputes. Further, the dispute resolution specialist can be a person who has successfully completed a comprehensive mediation training program, or can be a person who has knowledge of the legal parameters of dispute resolution practices.

Appellant argues that Figure 1 shows a marketplace 102 separate from the dispute resolution system. The Examiner agrees with this assertion. The Examiner agrees that the online marketplace is a website or an online centralized trading place. The appellant states on page 28 of the Appeal Brief that claims 111 and 115 require that the online dispute resolution system and the marketplace have separate databases. Appellant states on page 28 of the Appeal Brief that claim 111 provides further evidence that the proper construction of the term "marketplace" is a system and not an individual since claim 111 requires the marketplace to have a database.

However, the Examiner does not agree that this present application makes clear that the online marketplace is a system that provides a centralized trading place, and is not an individual buyer. Furthermore, the Examiner does not agree that this disclosure provides support for the limitation that the online dispute resolution system and the marketplace having separate databases.

Appellant argues that Figure 2B shows a "second implementation" 150 of the invention in which the dispute resolution system integrates with a business partner's system, such as the online marketplace 102. The appellant then argues that the totality of the description of Figure 2B makes clear that marketplace 102 of Figure 1 is an example of a partner system referred to in 2B. Appellant states that paragraph 48 expressly refers to partner systems as having "partner databases 164."

The paragraphs that the appellant is referring to are found on pages 13 and 14. To better understand Figure 2B, one would need to read paragraphs in the order which the specification provides.

[0045] Referring now to FIG. 2A, one implementation of the dispute resolution system 130 is shown. In this implementation, the dispute resolution system 130 includes a plurality of redundant, fail-over servers 132-136. The servers 132-136 are connected to the network 120. Moreover, each server 132 or 136 is connected to a data storage system 134 and 138, respectively. To support fail-over, each server 132 or 136 can provide resources independent of the other until one of the servers fails. Each server continuously monitors the other server. When one of the servers fails, the surviving server acquires the shared drives and volumes of the failed server and mounts the volumes contained on the shared drives. Applications that use the shared drives can also be started on the surviving server after the failover. Further, a manual-failover operation can be performed on the shared volumes at any time in order to perform tasks such as scheduled maintenance on one of the servers. As soon as the failed server is booted up and the communication between servers indicates that the server is ready to own its shared drives, the servers automatically start the recovery process.

[0046] Referring now to FIG. 2B, a second implementation 150 of the dispute resolution system is shown. In this implementation, *a customer (which can be either the seller or the buyer) or a dispute resolution specialist can access data using a web browser on a workstation 152. The data is securely transferred between the workstation 152 to a network 154.* The network 154 can be the Internet or can be an intranet. *A server 156 communicates with the network 154. The server 156 also communicates with a second server 158, which can be an e-commerce server* such as the ColdFusion server, available from Allaire Inc. *The server 158 is used as a Web Application Server to present HTML applications. These applications allow customers to file and manage disputes and dispute resolution specialists to manage cases over the Internet.*

[0047] *The server 158 receives data from a set of remote objects that reside in the partner's system 166. The remote objects, which can be enterprise Java Beans, are provided to allow business partners of the system to integrate with the dispute resolution system.* Both DCOM objects and Enterprise Java Beans models can be used. *These objects provide functionality to receive and send specific information to the dispute resolution system 130.* The objects will transparently deal with communication issues including server unavailability and performance. *Example functionality includes informing the dispute resolution system 130 of relevant partner transactions and allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.*

[0048] *The server 158 in turn communicates with a structured query language (SQL) server 160. The SQL server 160 also communicates with a data manager 162. The data manager 162 in turn communicates with one or more partner databases 164. Partners integrate with the system, by exposing relevant functionality on their respective websites, for example, allowing customers to dispute a transaction. This integration is achieved by a predefined set of URLs that a partner embeds in the partner's HTML application.*

[0049] Referring now to FIG. 3, a process 230 that provides a forum for rating buyers and sellers is shown. First, either a party such as a buyer or a seller can access the dispute resolution system (step 232). Next, the party can enter a password to access the system (step 234). If the password is correct, the process 230 allows the party to access information relating to the "performance" of another party (step 236). The process 230 then checks whether the party is finished with the checking process (step 238). If not, the process 230 loops back to step 236 to allow the party to continue looking up the performance of other parties. Alternatively, the process 230 exits.

From these excerpts the appellant then states that this clearly established that the inventors were in possession of the concept that *the online marketplace 102 Figure 1 has a separate database and electronically communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace.*

The appellant states that claim 111 specifically requires that the database of the marketplace and the database of the online dispute resolution system electronically communicate transaction data. Claim 115 is directed to the limitation of *wherein the online dispute resolution system comprises a data manager software application to automatically communicate data between the database of the online dispute resolution system and the database of the electronic marketplace.*

The Examiner asserts that appellant does not provide support for the two separate databases as appellant now is claiming. Appellant states on page 28 of the

Appeal Brief that the claims further comprise electronically communicating the

transaction data between the database of the online dispute resolution system and

database of the electronic marketplace. Appellant states that claim 111 specifically

requires that the database of the marketplace and the database of the online dispute

resolution electronically communicate transaction data.

Appellant further states on page 42 of the Appeal Brief that the present

application provides adequate support for the limitation of a data manager software

application to automatically electronically communicate the transaction data between

the database of the online dispute resolution system and the database of the electronic

marketplace. Appellant states that data manager 162 is described with respect to

Figure 2B as communicating with one or more of the partner databases 164.

Moreover, appellant asserts that the present application makes clear that remote

objects executing within the partner system and data manager 162 of online dispute

resolution system 160 allow integration in a manner that "transparently deals with

communication issues" between the partner system and the online dispute system.

Therefore, appellant asserts that according to the present application, the remote

objects within the partner system and the data manager 162 of the online dispute

transparently deal with communication of data between the partner database 164 and

database server 160 of the online dispute resolution system. Appellant further asserts

that the present application states that server 158 of the online dispute resolution

system 150 "receives data" from the remote objects executing with the partner system.

Appellant states that one specific example of data sharing provided by the present

application is the "functionality of informing the dispute resolution system 130 of relevant partner transactions."

Appellant states that based on at least this disclosure, one skilled in the art would reasonably conclude that the appellant was in possession of the claimed subject matter of automatically electronically communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace.

One can better understand the appellant's interpretation of claim 111 in appellant's arguments as to the prior art on pages 14-15 and 28-31 of the Appeal Brief and the discussion as to the limitations of claims 49-73 in co-pending application 10/672,136, also on appeal.

The appellant is interpreting the term "automatically" to mean that the transaction data is communicated between the two databases without human intervention. The Examiner asserts that appellant's disclosure does not provide for such communication to be performed without human intervention. Thus, the Examiner asserts that appellant is now directing appellant's claimed invention to a marketplace database and a dispute resolution database wherein communication occurs between the two databases without human intervention. The Examiner asserts that the subject matter in claims 111 and 115 was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner asserts that the limitations, as argued by the applicant, a marketplace database and a dispute

resolution database wherein communication occurs between the two databases without

human intervention, is new matter, not adequately supported by the original disclosure.

**The second Ground of Rejection to be Reviewed on Appeal is the rejection
of claims 1-17, 20-22, 25-27, 64-73, 93-99, 100,109, 110-113, and 115 under 35 USC
103(a) as being unpatentable over Sloo in view of Collins**

The arguments as to this ground of rejection are found on pages 12-33. The

Examiner notes that the appellant provides appellant's interpretation as to what each

prior art reference discloses or teaches on page 12 through page 15. Appellant does

not start to address the prior art rejection of the claims until page 15, the fourth

paragraph.

NOTE: As for the Collins reference (US 2002/0007362), the appellant points out

on page 14 of the Appeal Brief that Figure 1B of the Collins reference and related

disclosure [0045] do not qualify as prior art with respect to the present application.

Appellant states that the present application is a continuation of and claims priority to

serial number 09/504/149, filed February 15, 2000. (The Examiner notes that this must

be a typographical error since the instant application is 09/504,159). Collins was filed

April 38, 2000, but claims priority to three US provisional applications filed prior to the

priority date of the present application.

The Examiner asserts that Collins is a proper reference. Appellant is correct in

stating that MPEP 2136.03 states that the 35 U.S.C. 102(e) critical reference date of a

U.S. patent or U.S. application publications entitled to the benefit of the filing date of a

provisional application under 35 U.S.C. 1 19(e) is the filing date of the provisional

application if the provisional applications properly supports the subject matter relied

upon to make the rejection in compliance with 35 U.S.C. 1 12, first paragraph.

Appellant argues that the specific features of Figure 1B and the related description in

paragraph [0045] are not taught or suggested by the priority documents.

Claims 111 and 115 are claims that were first added to this application in the

amendment submitted on April 12, 2004.

The rebuttal to appellant's argument that Figure 1B and [0045] do not qualify as

prior art with respect to the present application involve the rejection of claims 111 and

115 under 35 USC 112, first paragraph.   The Examiner asserts that claims 111 and 115

contain new matter which does not get the benefit of appellant's February 15, 2006 filing

date. Furthermore, the Examiner asserts that Figure 1B and paragraph [0045] have not

been used to reject the appellant's claims.

Independent claim 1:

Claim 1 is directed to a method for resolving an electronic commerce dispute

involving one or more parties, comprising:

electronically providing access to an online dispute resolution system *to allow* at

least one of the parties to initiate a filing of the dispute from an online marketplace (the

Examiner notes that there is not a positive recitation of the parties actually initiating a

filing of a dispute from an online marketplace);

electronically receiving with the online dispute resolution system transaction data

from the marketplace, wherein the transaction describes transactions within the

marketplace (broadly read, this limitation could encompass an email containing

transaction data regarding a credit card dispute from an online transaction being sent to

one of more dispute resolution specialist via a network (page 12 of appellant's specification. Furthermore, the data could be entered manually).

receiving from at least one of the parties information related to the dispute (This limitation is broad enough to read on someone calling in information, emailing information, mailing in information. Moreover, information related to the dispute could simply be the name of the party);

executing software with the online dispute resolution system to apply an online dispute resolution process that utilizes at least a portion of the transaction data from the market place and the information to assist the parties in resolving the dispute (First, the Examiner assumes that "the information" refers to the parties information. Secondly, broadly read, the execution of the software that utilizes at least a portion of the transaction data and the information to assist the parties could be the execution of a guide that guides the user through the process of filling out a complaint form wherein the user enters the some information received about the transaction data and information about the user (pages 16-17 or the specification).

Appellant's argues that Sloo fails to teach or suggest the claimed invention of claim 1. (Appellant's brief page 12).

The Examiner respectfully disagrees.

Sloo discloses a method and a system for resolving a commerce dispute involving one or more parties (a *complaint handling apparatus (Figure 1)*) for resolving *complaints related to goods, class of goods, services, and/or venders, the subjects of the complaints may be manufacturers, distributors, wholesalers, retailers or any other*

responsible persons or entities (col. 3, lines 1-8) *with a plurality of access terminals* (col. 3, lines 8-11), comprising:

electronically providing access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute from a marketplace (Figs. 1-6, col. 2, line 53 thru col. 3, line 7 - *the complaint handling apparatus 10 broadly includes a central computer 12 and a plurality of access terminals coupled with the central computer by a communication network 16*; (col. 3, lines 8-39) (electronically providing access to an online dispute system); *the access terminals receive complaints and responses from the users* (col. 3, lines 18-20) (to allow one of the parties to initiate a filing of a dispute); *the users of the apparatus who file complaints may include individuals, businesses, organizations or other entities and the complaints may relate to goods, classes of goods, services, and/or vendors, individuals, organizations or any object, the subject of the complaint may be individuals, manufacturers, distributors, wholesalers, retailers)* (col. 3, lines 1-8) (wherein the dispute may be filed from a marketplace) *(retailer, wholesaler, complaints relating goods and services*; col. 17, line 66 thru col. 18, line 16 *consumer complaint module)*;

electronically receiving with the online dispute resolution system transaction data from the marketplace, wherein the transaction data describes transactions within the marketplace (the Examiner interprets "electronically receiving data" to include data entered manually and transmitted through a communication network - Figs. 3-9; col. 2, lines 7-20 - *receiving complaints and responses over the communication network* (col. 3, lines 18-20) (electronically receiving with the online dispute resolution system

transaction data (*responses*), *the users of the apparatus who file complaints may*

include individuals, businesses, organizations or other entities and the complaints may

relate to goods, classes of goods, services, and/or vendors, individuals, organizations or

any object, the subject of the complaint may be individuals, manufacturers, distributors,

wholesalers, retailers (from a marketplace) wherein *the apparatus receives complaints,*

notifies the subject of the complaints, receives responses from the subject (transaction

data from the marketplace)*, stores the complaints and associated responses in*

individual data records (col. 2, lines 56-59); see also, col. 2, lines 56-59; see Figure

(500) and discussion as to Figure 5 (column 5, line 66 through column 6, line 14 and

col. 6, lines 55-60) – *this portion of the program permits a subject to respond to a*

complaint issued against it. The subject may respond to the complaint by entering

information in one of the access terminals and e-mailing or transmitting the information

to the central computer by way of the communication network) *(responses to the*

complaints are received – see Figure 5 (500). (The Examiner is interpreting a response

to a complaint from a retailer via the complaint handling apparatus as transaction data

being received from the marketplace. Electronically receiving transaction data would

include data entered manually into a computer and would include any communication

over the network*)*;

receiving from at least one of the parties information (*complaint*) related to the

dispute (col. 2, lines 53-65; col. 3, lines 19-29 *the access terminals 14 receive*

complaints and responses from the user, deliver them to the central computer 12

(column 2, lines 56-57, column 3, lines 19-29); and

executing software with the online dispute resolution system (artificial intelligence

(e.g. neural network linking)) to apply an online dispute resolution process that utilizes

at least a portion of the transaction data and the information to assist the parties in

resolving the dispute (col. 3, lines 8-67 - *each access terminal includes conventional*

memory and software for communicating with and interpreting the data sent from the

central computer (col. 3, lines 8-67); col. 1, line 66 thru col. 2, line 6 *the central*

computer is programmed to receive complaints and responses, store the complaints

and responses in individual data records, and negotiate settlements to the complaints;

col. 2, lines 12-20 and Figure 9 - *the central computer is programmed to monitor and*

rate the conduct and performance of both the complainants and the subjects; the ratings

can be used to affect the outcome of the disputes and hold the parties accountable for

their conduct; col. 9, line 40 through col. 10, line 39 *when the program uses artificial*

intelligent techniques to make a decision regarding a dispute, it considers the

performance records of all participants to the dispute when rendering a judgment; the

program evaluates all of the gathered information to arrive at a judgment; the program

may compare the characteristics from the current data record with the characteristics

from the data records for the previously resolved complaints to arrive at an appropriate

judgment; col. 10, lines 58-61 *by monitoring participant behavior in certain situations*

and outcomes over time the program may compare the current situation with other

similar situations having known outcomes and predict the outcome for the present

situation based on known outcomes. Artificial intelligence techniques may be used to

predict an outcome based on what it has learned about behavior, situations and their

outcomes. Thus, the program may suggest the best behavior to a user).

Appellant argues that Sloo fails to teach or suggest (1) *initiating a filing of the*

dispute from an online marketplace, (2) *electronically receiving with the online dispute*

resolution system with the online dispute resolution system transaction data from the

marketplace, (3) *at least a portion of the transaction data from the marketplace* (pages

18 and 19 of the Appeal Brief).

The Examiner respectfully disagrees with this assertion.

First, Sloo discloses initiating a filing of the dispute from an online marketplace.

Sloo discloses an complaint handling apparatus (10) (col. 2, line 53) constructed with

access terminals 14 for receiving complaints and responses from users (col. 3, lines 18-

19) over a communication network (16) (col. 3, line 31) wherein the users can be

retailers, manufacturers, distributors, wholesalers (col. 2, line 66 through col. 3, line 7).

Secondly, the broadest reasonably interpretation of the appellant's claim

limitation could lead one to interpret the claim limitation to be allowing at least one of the

parties to initiate a filing of a dispute, wherein the subject matter of the dispute is a

dispute arising from an online marketplace, especially in light of the preamble.

Appellant is claiming a method for resolving an electronic commerce dispute involving

one or more parties. A broad, but reasonable, reading of the preamble would mean that

appellant's invention is directed to a method for resolving a brick and mortar transaction

dispute, wherein the dispute relates to the credit card transaction which occurred

electronically. Appellant's claim limitation can be interpreted as allowing a dispute to be

initiated by providing access to any dispute resolution system. The party could have a

dispute involving an electronic commerce transaction arising from an online

marketplace.

Third, a careful reading of appellant's specification to identify how the appellant

defines a marketplace would not lead one to define the term as the appellant is now

attempting to define the term. On page 6 of the specification the appellant discloses:

> In a second aspect, a system for resolving online disputes includes a
> network; *an electronic marketplace coupled to the network; one or more*
> *sellers selling one or more items at the marketplace; one or more buyers*
> *consuming one or more items at the marketplace;* and *a dispute resolution*
> *system coupled to the network to resolve a dispute between one or more*
> *buyer and seller parties, the dispute resolution system adapted to select*
> *one of two modes* of resolving the dispute, the first mode being completely
> driven by an electronic agent and the second mode involving a dispute resolution
> specialist.

Fourth, Sloo discloses electronically receiving with the online dispute resolution

system transaction data from the marketplace (retailer, wholesaler, complaints relating

goods and services) (responses to the complaints are received – see Figure 5 (500). If

a retailer responds to a complaint via the complaint handling apparatus, transaction

data is being received from the market place. Electronically receiving transaction data

would include data entered manually into a computer and would include any

communication over the network.

Fifth, Sloo discloses a process that utilizes at least a portion of the transaction

data from the market place. The complaint handling apparatus of Sloo may draw from

available data (this includes complaints and responses) and inform the Appellant about

what action to take (col. 3, lines 18-29, col. 14, lines 2-16), thus using a portion of the

retailers marketplace transaction data to make this determination

As for the Appellant's contention that Sloo fails to show certain features of the

Appellant's invention (page 13 of the Appellant's appeal brief), it is noted that the

features upon which Appellant relies (i.e., an online dispute system *integrated with a*

partner system, wherein the partner system is an online marketplace; the partner

system may automatically *share* specific information of relevant partner transactions, an

electronic integration of an online marketplace with a dispute resolution system) are not

recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re*

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, the Examiner asserts that the appellant's claims are rejected as being

unpatentable over Sloo in view of Collins. Although Sloo discloses that the complaints

may relate to goods, classes of goods, services, and/or the vendors (col. 3, lines 2-7)

and transaction data (col. 9, lines 57-63), Sloo does not specifically disclose that the

marketplace is an electronic marketplace or that the process utilizes at least a portion of

the transaction data from the electronic marketplace in resolving the dispute.

However, Collins specifically discloses an electronic marketplace ([0039] *a*

customer may have a dispute with a merchant. The dispute may arise in connection

with a transaction occurring over the Internet) and that the process utilizes at least a

portion of the transaction data from the marketplace in resolving the dispute ([0042]

each party sends position data over the network to central server 120; the relational

database associates the data from each party to components in the database to form

the ZOPA (zone of possible agreement) template).

The appellant states that in an Office action, the Examiner recognizes that the

Sloo system is a stand-alone, computer-based complaint handling system that is not

accessible by any other system, that the Examiner recognizes that the Sloo system

does not allow disputes to be initiated by any other system and that the system requires

individual users to directly access the Sloo system and manually provide all information

related to a dispute and that the Examiner recognizes that Sloo does not describe

resolution of network-based transactions (page 13 of the Appeal Brief). The Examiner is

not sure where in the Office action that the Examiner made these alleged statements.

Furthermore, the Sloo system is accessible over a network, therefore, it is accessible by

another system. Secondly, the Examiner asserts that appellant's invention also

provides for the manually entry of information relating to the dispute on page 11 of the

specification wherein the appellant discloses:

> The seller 104 may be a manufacturer. The marketplace 102 and the seller 104
> can communicate directly with each other, or can communicate over a network
> 120. The network 120 can be a wide area network such as the Internet. The one
> or more consumers 106 can communicate with the marketplace 102 and
> indirectly the seller 104 over the network 120. A multiparty community 110
> having a first party 112, a second party 114 and an nth party 116 can
> communicate with the network 120. Further, the first party 112, second party 114
> and nth party 116 can communicate directly with each other.

> Also connected to the network 120 is a dispute resolution system 130, which is
> detailed below. The dispute resolution system 130 can communicate directly
> with a network having one or more dispute resolution specialists 140.
> Alternatively, the dispute resolution specialists 140 can access the dispute
> resolution system 130 using the network 120.

Third, the Examiner asserts that a dispute involving any transaction over a computer network would be a network-based transaction.

Moreover, the limitation of electronically receiving with the online dispute resolution system transaction data from the marketplace only requires that the data be transmitted electronically. The Examiner asserts that this does not preclude the manual entry of data.

The appellant asserts on page 20 of the Appeal Brief that the Examiner rejects appellant's claim based on the erroneous reasoning that claim 1 covers individuals or entities separately and manually accessing the Sloo complaint handling system involving disputes that may have at some time been previously involved in a form of commerce on the Internet. The appellant states that the Examiner argues that because an individual may have at some point previously bought or sold goods in commerce, then the stand alone Sloo system teaches the elements of claim 1. The Examiner asserts that this is, in fact, the Examiner's position.

Again on page 20, appellant argues that Collins makes clear that the parties manually enter all data describing the situation. The Examiner asserts, once again, that appellant's claim language does not exclude the manual entry of data. The term "electronically receiving" only require that the data be transmitted electronically to the online dispute resolution system.

The appellant states that the one issue for review with respect to claim 1 is whether the Examiner's construction of claim 1 and conclusions of obviousness are correct in view of the intrinsic evidence, including the specification and the plain

language of claim 1 and other claims. In summary, the appellant states that the

Examiner has construed claim 1 to cover the following:

1). a retailer or other party conducting transactions over the Internet,

2). that same party directly accessing the Sloo system at some later point in time

to initiate a dispute, and

3). that same party manually interacts with the Sloo system to enter all dispute

information.

Appellant argues that claims are generally given their ordinary meaning and that

the Court has made clear that the ordinary meaning of a term is the meaning to one of

ordinary skill in the art not only in the context of the particular claim but in the context of

the entire patent, including the specification. The Examiner agrees with appellant as to

giving claims their ordinary meaning.

The appellant states that the plain language of claim 1 in view of the intrinsic

evidence and the language of other claims requires a different construction of the term

"online marketplace" than the Examiner's construction. The appellant states that the

present application describes "an online marketplace" as "a website or an online

centralized trading place. The appellant states the present application gives a specific

example of an online marketplace as eBay, which is a well-known centralized trading

place. The Appellant states that the present application makes clear that the online

marketplace is a system that provides a centralized trading place, and not an individual

buyer or seller.

The Examiner disagrees with this assertion and again directs the appellant to

pages 11 and 12 of the specification wherein application discloses:

> FIG. 1 shows an environment 100 that supports electronic dispute
> resolution. In this environment, one or more sellers 104 offer their products
> and/or services to one or more consumers 106 at a marketplace 102. The
> marketplace 106 can be a physical mall or market or can be a website such as
> an online centralized trading place. The centralized trading place overcomes the
> inefficiencies associated with traditional person-to-person trading by facilitating
> buyers and sellers meeting, listing items for sale, exchanging information,
> interacting with each other and, ultimately, consummating transactions. Through
> such a trading place, buyers can access a significantly broader selection of
> goods to purchase and sellers have the opportunity to sell their goods efficiently
> to a broader base of buyers.
>
> One exemplary person-to-person trading place on the Internet is eBay, located at
> www.eBay.com. eBay is a Web-based community in which buyers and sellers
> are brought together in an efficient auction format to buy and sell items such as
> antiques, coins, collectibles, computers, memorabilia, stamps and toys. The
> eBay service permits sellers to list items for sale, buyers to bid on items of
> interest and all users to browse through listed items in a fully-automated,
> topically-arranged online service that is available 24 hours a day, seven days a
> week.
>
> The seller 104 may be a manufacturer. The marketplace 102 and the seller 104
> can communicate directly with each other, or can communicate over a network
> 120. The network 120 can be a wide area network such as the Internet. The
> one or more consumers 106 can communicate with the marketplace 102 and
> indirectly the seller 104 over the network 120. A multiparty community 110
> having a first party 112, a second party 114 and an nth party 116 can
> communicate with the network 120. Further, the first party 112, second party 114
> and nth party 116 can communicate directly with each other.

The appellant provides the trading place on the Internet as an example of a

person-to-person trading place. The appellant also discloses that the marketplace can

be a physical mall or market or a website such as an online centralized trading place.

However, the wording "such as" does not mean that the term excludes other websites.

The Examiner asserts that any retail website would be included in the terminology

"online marketplace" as defined in the appellant's specification. If the appellant wants a

narrower definition of the terminology marketplace, the appellant should put the

limitations in the claim language. MPEP requires the Examiner to give claim language

the broadest reasonable interpretation in light of the specification without reading

limitations from the specification into the claim language. Thus, for the Examiner to

interpret an "electronic marketplace" to be a website that is a centralized trading place,

the Examiner would have to read limitations into the claim language. In response to

appellant's argument that the references fail to show certain features of appellant's

invention, it is noted that the features upon which appellant relies (i.e., a website that

provides a centralized trading place for buyers and sellers) are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellant states that the plain language of claim 1 uses the term that the

"online marketplace" separately from the term "parties." Appellant states that if the

appellant meant the term "online marketplace" to mean individual buyers or sellers that

had at some time been involved in commerce, i.e., a party, then appellant would have

used different terms.

Once again the Examiner directs the appellant to pages 11 and 12 of the

specification, wherein the appellant discloses:

> FIG. 1 shows an environment 100 that supports electronic dispute
> resolution. In this environment, one or more sellers 104 offer their products
> and/or services to one or more consumers 106 at a marketplace 102. The
> marketplace 106 can be a physical mall or market or can be a website such as

an online centralized trading place. The centralized trading place overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions. Through such a trading place, buyers can access a significantly broader selection of goods to purchase and sellers have the opportunity to sell their goods efficiently to a broader base of buyers.

The seller 104 may be a manufacturer. The marketplace 102 and the seller 104 can communicate directly with each other, or can communicate over a network 120. The network 120 can be a wide area network such as the Internet. The one or more consumers 106 can communicate with the marketplace 102 and indirectly the seller 104 over the network 120. A multiparty community 110 having a first party 112, a second party 114 and an nth party 116 can communicate with the network 120. Further, the first party 112, second party 114 and nth party 116 can communicate directly with each other.

Until the appellant claims the "online marketplace" in a manner to exclude individual buyers and sellers, then the Examiner is giving the terminology the broadest reasonable interpretation in light of the specification. The appellant clearly states that the marketplace can be a physical mall or market or can be a website *such as* an online centralized trading place. This language does not exclude an "electronic marketplace" from being a seller with a website in which the consumer can buy goods, such as LL Bean or Sears or Lands' End.

Appellant asserts that because of the language in claim 1 which requires electronically *providing access to an online dispute resolution system to initiate a filing of the dispute from an online marketplace*, that the term "from" is consistent with the construction that the online marketplace is an electronic system that provides a trading place and not an individual that conducts commerce, as interpreted by the Examiner. The Examiner asserts that one can read the claim language the way the appellant has.

However, the Examiner also asserts that the claim language is written in a manner to allow for other interpretations which are consistent with the applicants disclosure. As stated above, the limitation can be read to mean providing access to any online dispute resolution system for the purpose of allowing one of the parties to initiate a filing of an electronic commerce dispute, i.e., a credit card dispute, which occurred in a transaction involving an online marketplace, i.e., LL Bean.

Appellant then argues that dependent claim 111 requires that the online marketplace and the dispute resolution system have separate database and in view of the plain language of claim 1, the plain language of dependent claims and the intrinsic evidence, proper construction of the term "online marketplace" is a system that provides a centralized trading place for buyers and sellers. The Examiner disagrees with this assertion for the reasons set forth above. Furthermore, the fact that the marketplace and the dispute resolution system have separate databases, as asserted by the applicant, would not change the Examiner's interpretation of claim 1. As stated above, the limitation can be read to mean providing access to any online dispute resolution system with a database for the purpose of allowing one of the parties to initiate a filing of an electronic commerce dispute, i.e., a credit card dispute, which occurred in a transaction involving an online marketplace with a database, i.e., LL Bean.

Appellant contends that with respect to independent claim 112, Sloo fails to teach or suggest an online dispute resolution system that electronically receives transaction data from a marketplace.

The appellant argues that contrary to the Examiner's assertion, an individual or entity that may have been previously involved in some form of commerce and later submitting a complaint to the standalone Sloo or Collins complaint handling system fails to teach or suggest that transaction data is actually electronically communicated from the online marketplace itself to the online dispute system (electronically receiving with the online dispute resolution system transaction data from the marketplace, wherein the transaction data describes transactions within the marketplace). The appellant states that the Examiner expressly argues that the claim elements of electronically receiving transaction data from an online marketplace cover individuals previously involved in commerce and later manually entering data directly into the Sloo complaint system. The appellant asserts that the Examiners construction of claim 1 is incorrect and thus the Examiner's conclusion of obviousness based on that construction is erroneous. Appellant asserts that the proper construction of the term "online marketplace" is a system that provides a centralized trading place and claim 1 require providing accesses to an online dispute resolution system so that disputes can be initiated form an online marketplace itself and that transaction data is provided from the online marketplace to the online dispute system. The appellant asserts that at the end of claim 1, the Examiner correctly recognizes that Sloo fails to describe an "electronic" marketplace or that the Sloo system utilizes a portion of the transaction data from an electronic marketplace. Appellant states that the Examiner makes a passing reference to Collins stating Collins teaches a dispute resolution system and that one party "may be a merchant" and the transaction "may arise in connection with a transaction that occurred

over the Internet." Appellant states that, with respect to Collins, the Examiner continues to misconstrue appellant's claim language.

Appellant admits that Collins makes clear that the parties manually enter all data describing a "situation." The Examiner asserts that manually entering transaction data describing a transaction between a merchant, LL Bean, and a consumer that takes place over the Internet and sending it to a dispute resolution system (complaint handling system) is, in fact, electronically receiving with the online dispute resolution system transaction data from the marketplace, i.e., LL Bean, wherein the transaction data describes a transaction within the marketplace as defined by appellant. Appellant states on page 11 of the specification that *marketplace 106* can be a physical mall or marketplace or a website such as an online centralized trading. Electronically receiving data would include data entered manually and transmitted through a communication network.

Independent claim 112

Claim 112 is a system claim.

Claim 112 is directed to a system comprising,

an online dispute resolution system that electronically receives transaction data from a marketplace that provides a web-based community having buyers and sellers of goods and services, the transaction data describing transactions within the electronic marketplace,

wherein the dispute resolution system executes software that utilized the

transaction data and applies a dispute resolution process to assist the buyers or sellers

in resolving disputes relating to the transactions, and

wherein the online dispute resolution system electronically provides status data

to the marketplace based on participation of the buyers or sellers within the online

dispute resolution process.

Appellant states that claim 112 is directed to an online dispute resolution system

that electronically receives transaction data form a marketplace that provides a web-

bases community having buyers and sellers of goods and services. Appellant states

that like claim 1, claim 112 uses the term "marketplace" separately from the terms

"buyers" and "sellers." Appellant states that, moreover, the language of claim 112

expressly requires that the "marketplace" provide a "web-based" community having

buyers and sellers of goods and services. Thus, the appellant asserts that, in view of

the plain language of claim 112 and the intrinsic evidence discussed above, proper

construction of claim 112 requires that the marketplace is an online system that

provides a web-based community for buyers and sellers.

Appellant is erroneously trying to define the system by what it does rather than

the specific structure. The entire claim 112, other that the online dispute resolution

system, is directed to what the system does rather than the structure of the system.

The structure of claim 112 is directed to a system, the system comprising an

online dispute resolution system that electronically receives data from a web-based

marketplace, wherein the dispute resolution system executes software that utilizes

transaction data and applies a dispute resolution process to assist users; wherein the

system provides data on the status of users of the system.

The Examiner rejected claim 112 as being unpatentable over Sloo in view of

Collins. The Examiner's rejection is set forth below:

Referring to Claim 112:

Sloo discloses a system that electronically receives transaction data from a

marketplace (Figs. 3-9; col. 2, lines 7-20 - *receiving complaints and responses over the*

communication network (col. 3, lines 18-20) (electronically receiving with the online

dispute resolution system transaction data (*responses*), *the users of the apparatus who*

file complaints may include individuals, businesses, organizations or other entities and

the complaints may relate to goods, classes of goods, services, and/or vendors,

individuals, organizations or any object, the subject of the complaint may be individuals,

manufacturers, distributors, wholesalers, retailers (from a marketplace) wherein *the*

apparatus receives complaints, notifies the subject of the complaints, receives

responses from the subject (transaction data from the marketplace), *stores the*

complaints and associated responses in individual data records (col. 2, lines 56-59); see

also, col. 2, lines 56-59; see Figure (500) and discussion as to Figure 5 (column 5, line

66 through column 6, line 14 and col. 6, lines 55-60) – *this portion of the program*

permits a subject to respond to a complaint issued against it. The subject may respond

to the complaint by entering information in one of the access terminals and e-mailing or

transmitting the information to the central computer by way of the communication

network) *(responses to the complaints are received – see Figure 5 (500). (* the

Examiner is interpreting that a response to a complaint from a retailer via the complaint

handling apparatus as transaction data being received from the market place.

Electronically receiving transaction data would include data entered manually into a

computer and would include any communication over the network);

wherein the system executes software that utilizes the transaction data and

applies a dispute resolution process (col. 3, lines 8-67 - *each access terminal includes*

conventional memory and software for communicating with and interpreting the data

sent from the central computer (col. 3, lines 8-67); col. 1, line 66 thru col. 2, line 6 *the*

central computer is programmed to receive complaints and responses, store the

complaints and responses in individual data records, and negotiate settlements to the

complaints; col. 2, lines 12-20 and Figure 9 - *the central computer is programmed to*

monitor and rate the conduct and performance of both the complainants and the

subjects; the ratings can be used to affect the outcome of the disputes and hold the

parties accountable for their conduct; col. 9, line 40 through col. 10, line 39 *when the*

program uses artificial intelligent techniques to make a decision regarding a dispute, it

considers the performance records of all participants to the dispute when rendering a

judgment; the program evaluates all of the gathered information to arrive at a judgment;

the program may compare the characteristics from the current data record with the

characteristics from the data records for the previously resolved complaints to arrive at

an appropriate judgment; col. 10, lines 58-61 *by monitoring participant behavior in*

certain situations and outcomes over time the program may compare the current

situation with other similar situations having known outcomes and predict the outcome

for the present situation based on known outcomes. Artificial intelligence techniques

may be used to predict an outcome based on what it has learned about behavior,

situations and their outcomes. Thus, the program may suggest the best behavior to a

user)

wherein the system electronically provides status data based on the participation

of the parties (col. 2, lines 7-12 *the central computer is programmed to provide public*

access to the data records to permit viewing of the corresponding complaints,

responses, and settlements for allowing other users to gauge the conduct of the subject;

col. 6, lines 24-32 *the monitoring information is stored in the subject's performance*

record and used to rate the subject's conduct; Figure 9 Monitor Compliance (900);

update performance records (908); col. 11, line 44 thru col. 12, line 14).

The Examiner asserts that although Sloo discloses that the complaints may

relate to goods, classes of goods, services, and/or the vendors (col. 3, lines 2-7) and

transaction data (col. 9, lines 57-63), Sloo does not specifically disclose that the

marketplace is an electronic marketplace or that the process utilizes at least a portion of

the transaction data from the marketplace in resolving the dispute.

However, Collins specifically discloses an electronic marketplace ([0039] *a*

customer may have a dispute with a merchant. The dispute may arise in connection

with a transaction occurring over the Internet) and that the process utilizes at least a

portion of the transaction data from the marketplace in resolving the dispute ([0042]

each party sends position data over the network to central server 120; the relational

database associates the data from each party to components in the database to form

the ZOPA template).

The Examiner asserts that it would have been obvious to one of ordinary skill in

the art at the time of the invention to combine the electronic marketplace and

marketplace data with the complaint handling method and system of Sloo so as to

facilitate agreements in disputes involving transactions occurring over the Internet

between a merchant and a consumer.

The language defining the marketplace as a web-based community having

buyers and sellers of goods and services is an attempt to define a system by a

characteristic rather than by its specific structure. Collins identifies a system for

facilitating agreement between a customer and a merchant wherein the transaction may

have occurred over the Internet ([0039]). Therefore, the Examiner has reason to

believe that the systems of Collins and Sloo would be capable of resolving disputes

over a marketplace defined as a web-based community having buyers and sellers of

goods and services.

Furthermore, the type of data being transmitted in the system is considered to be

non-functional descriptive data not interrelated with the useful structure of the system

and thus will not serve as a limitation. This descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, sees *In re Gulack,* 703 F.

2d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F. 3d 1579, 32

USPQ 2d 1031 (Fed. Cir. 1994).

Moreover, the recited statement of intended use of the system, to assist the buyers or sellers in resolving disputes relating to the transactions, does not patentably distinguish the claimed invention.

The appellant states that the Examiner construes appellant's claim element of "an online dispute resolution system that electronically receives transaction data from a marketplace that provides a web-based community having buyers and sellers of goods and services" to include any individual or entity that may have at some time been previously involved in a form of commerce on the Internet. The appellant states that the Examiner argues that the requirements of appellant's claim 112 are obvious because Sloo in view of Collins teaches a retailer conducting a transaction over the Internet and subsequently manually accessing the standalone Sloo complaint handling system and filing a dispute.

The appellant further states that the Examiner similarly construes the requirement of claim 112 that the online dispute resolution system electronically provide status data to the marketplace to encompass a retailer accessing the Sloo dispute resolution system and merely viewing complaints and responses. The appellant states that it is evident that the Examiner is construing the language of "a marketplace that provides a web-based community having buyers and sellers of goods" as a retailer that at some point conducted commerce over the Internet. Appellant asserts that appellant strongly disagrees with the Examiner's construction of claim 112 and conclusions with respect to Sloo and Collins for reasons set forth above with respect to claim 1.

Appellant then states that claim 112 expressly requires that the marketplace

provide a web-based community. Further, appellant states that claim 112 requires that

the online dispute resolution system electronically provide status data back to the

marketplace based on participation of the buyers or sellers with in the online dispute

resolution process. Appellant states that as described in the present application on

pages 13 and 14, software objects executing in a partner system provide integrated

functionality to receive and send specific information to the dispute resolution system.

The partner system can query the dispute resolution system data to receive status of a

particular marketplace seller. Based on the status, the partner system can provide

visual indicia that a seller in a transaction has membership in the dispute resolution

system.

First, the Examiner notes that the appellant's invention in claim 112 is directed to

a system. The only structure in the application system is the on line dispute resolution

system. The rest of claim 112 is directed to the method of using the system. Appellant

clearly is trying to define the system by the steps performed by the system or the

method of use of the system. In a system claim, method steps are not a proper way of

defining the system. Furthermore, they make one wonder what appellant is really trying

to claim in claim 112, a system or a method. Furthermore, the appellant fails to

explicitly define the term "marketplace" in the specification as appellant is now arguing

the meaning of the term. It appears that appellant trying to redefine the term

marketplace in the middle of prosecution without putting any limitation in the claim

language that would force one to have to take such a narrow interpretation. Even in

claim 112, the appellant has the online dispute resolution system electronically receiving

transaction data from a marketplace. The Examiner notes that in a system claim, any

online dispute resolution system that receives data over a network is electronically

receiving data and is fully capable of receiving any electronic data. Furthermore, as

written in claim 112, the marketplace can be a physical facility that provides a web-

based community having buyers and sellers of goods. An interpretation of the facility

sending transaction data over a network to a dispute resolution system, the data

involving a transaction with the electronic marketplace, would be reasonable and

commensurate with the appellant's definition of a marketplace as defined in appellant's

specification.

As for the limitation of the wherein the online dispute resolution system provides

status data to the marketplace based on participation of the buyers or sellers within the

online dispute resolution process, the broadest reasonable interpretation of this

limitation would be a user of the online dispute resolution system transmitting data to

the marketplace facility stating that the parties had begun negotiation, thus the status of

the participation of the buyers and sellers.

Sloo clearly discloses an online dispute resolution system (*complaint handling
apparatus* 10, col. 2, lines 53-56) that electronically receives transaction data (*access
terminals* 14 *receive complaints and response from the users and receive transmissions
from the central computer*, col. 3, lines 18-20), the system executing software (*software
for communicating with and interpreting the data*, col. 3, lines 24-27; *the apparatus is
capable of drawing from available data and informing the participant about what action*

to take) that utilizes the transaction data to assist in the resolution of the dispute, and a system which provides status data (*the central computer is programmed to monitor and rate the conduct and performance and provide access to data records*, col. 2, lines 7-20)

Appellant states that Examiner has erroneous concluded that the requirements of claim 112 that the online dispute resolution system electronically provide status data to the marketplace is obvious over Sloo in view of Collins based on the Examiner's reasoning that Sloo describes a retailer manually accessing the Sloo dispute resolution system and viewing complaints and responses. The Examiner asserts that providing any data as to the position or point of progress of parties in an online dispute over a network to a marketplace facility would be providing status data to the marketplace.

Dependent Claims 111 and 115:

The Examiner asserts that appellant does not have support for claims 111 and 115 in the original disclosure as set forth in the rejection under 35 USC 112, 1st paragraph above.

Appellant states that claim 111 requires that the online dispute resolution system and the marketplace have separate database and the claim further comprises automatically electronically communicating the transaction data between the database of the online dispute resolution system and the database of the database of the electronic marketplace. Appellant states that claim 111 provides further evidence that the proper construction of the term "marketplace" is a system and not an individual since claim 111 requires that the marketplace have a database. Moreover, appellant

asserts that claim 111 specifically requires that the database of the marketplace and the

database of the online dispute resolution system electronically communicate transaction

data.

Appellant states that claim 115 requires that the online dispute resolution system

and the marketplace have separate databases and that the online dispute resolution

system includes a data manager software application to automatically communicate

data between the databases of the online dispute resolution system and the database of

the electronic marketplace.

Appellant argues that these requirements can be mapped to Figures 1 and 2B.

Appellant states that with respect to Figure 2B, the present application states that the

online dispute system 130 communicates with partner databases 164 and that partner

data for relevant transaction in dispute can be electronically communicated from

marketplace 102 to dispute resolution system 130 by way of remote software objects

executing with the marketplace and the data manager 162 executing within the online

dispute resolution system 102.

The Examiner asserts that appellant's specification does not disclose this

teaching.   Figure 2B is disclosed in the appellant's specification as follows:

> Referring now to FIG. 2B, a second implementation 150 of the dispute
> resolution system is shown. In this implementation, *a customer (which can be
> either the seller or the buyer) or a dispute resolution specialist can access
> data using a web browser on a workstation 152. The data is securely
> transferred between the workstation 152 to a network 154.* The network 154
> can be the Internet or can be an intranet. *A server 156 communicates with the
> network 154. The server 156 also communicates with a second server 158,
> which can be an e-commerce server* such as the ColdFusion server, available
> from Allaire Inc. *The server 158 is used as a Web Application Server to
> present HTML applications. These applications allow customers to file and*

> *manage disputes and dispute resolution specialists to manage cases over the Internet.*
>
> *The server 158 receives data from a set of remote objects that reside in the partner's system 166. The remote objects, which can be enterprise Java Beans, are provided to allow business partners of the system to integrate with the dispute resolution system.* Both DCOM objects and Enterprise Java Beans models can be used. *These objects provide functionality to receive and send specific information to the dispute resolution system 130.* The objects will transparently deal with communication issues including server unavailability and performance. *Example functionality includes informing the dispute resolution system 130 of relevant partner transactions and allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.*
>
> *The server 158 in turn communicates with a structured query language (SQL) server 160. The SQL server 160 also communicates with a data manager 162. The data manager 162 in turn communicates with one or more partner databases 164. Partners integrate with the system, by exposing relevant functionality on their respective websites, for example, allowing customers to dispute a transaction. This integration is achieved by a predefined set of URLs that a partner embeds in the partner's HTML application.*

The appellant states that the Examiner asserts that appellant's claim 111 is obvious over Sloo inv view of Collins based on the sole reason that Collins teaches that one of the users accessing the standalone system of Collins in Figure 1A may be a merchant and that the transaction being disputed may have occurred over the Internet. The appellant states that, thus, the Examiner argues that manual entry by a user into the standalone Collins system teaches appellant's requirement of automatically electronically communicating transaction data between a database of the online dispute resolution system and a database of an electronic marketplace.

First, the Examiner asserts that having a database does not preclude manual entry of data. Claim 111 depends on claim 1.

Secondly, the Examiner rejected claims 111 and 115 as follows:

Collins discloses a method and system with an online dispute resolution system

(Figure 1a ZOPA database (140)) and marketplace ([0039] *customer may have a*

dispute with a merchant regarding a transaction occurring over the Internet), the method

and system further comprising:

automatically electronically communicating the transaction data between the

database on the online dispute resolution system and the electronic marketplace ([0039]

and [0042].

The Examiner asserts that while Collins discloses the online dispute resolution

system having a database (Figure 1a ZOPA database (140)) neither Collins nor Sloo

explicitly disclose a marketplace database.

However, the Examiner asserts that it would have been obvious to one of

ordinary skill in the art at the time of the invention to incorporate into the complaint

handling systems of Sloo and Collins a marketplace with a database so as to provide

the marketplace with a means of maintaining transaction data concerning customers

and transaction.

NOTE: Appellant is directed a recent CAFC decision, *Collegenet, Inc. v.*

Applyyourself, Inc. (CAFC, 04-1202-1222, 1251, 8/2/2005) wherein the court held that

"automatically" means "without human interaction, but may be human initiated or

interrupted." Therefore, a process may be automatic even though a human initiates it.

The appellant states that the Examiner does not cite any evidence whatsoever as

to how it would be obvious to one of ordinary skill in the art to incorporate a marketplace

into the Sloo or Collins complaint handling systems and automatically communicate

transaction data from the marketplace database to the online dispute resolution system

database as required by 111 and 115. However, the Examiner asserts that any

merchant that provides transactions over the Internet will inherently have some form of

memory. Thus, the Examiner asserts that providing a marketplace with a database

would have been an obvious form of memory. Moreover, Collins discloses:

> [0039] In one potential application, for example, a customer may have a dispute
> with a merchant. The dispute may arise in connection with a transaction
> occurring over the Internet or the dispute may involve a transaction that occurred
> under other circumstances. A dispute may also arise in connection with multiple
> transactions related to one customer or one customer account. For example, a
> customer with a credit card account may dispute one or more items appearing on
> a credit card statement, each item corresponding to a purchase transaction. The
> customer may contact the issuer of the credit card to resolve such a dispute.

As disclosed above, Collins is directed to a customer having a dispute with a

merchant arising over a transaction occurring over the Internet. The dispute may arise

in connection with the customer's account, wherein the customer disputes one or more

item appearing on a credit card statement. There Examiner asserts that inherently, the

merchant has to store the transaction somewhere to be able to gain access to it once

the credit card statement is received by the applicant. Thus, at the very least, a

merchant providing online transaction will have a memory of some sort as a way of

maintaining account information.

Moreover, Collins discloses:

> [0042] In Fig. 1a, Party A and Party B engage in a negotiation session to
> resolve a situation. Although Fig. 1a shows only two parties there may be more
> than two parties engaged in a negotiation session. Each party preferably has a
> computer 110 and each party's computer 110 is connected to a central server
> 120 through a network. Party A initiates a negotiation session by connecting with

the central server 120 and providing data to the central server 120 concerning the nature of the situation and the identity of Party B. Party B is then contacted by the central server 120 and asked to engage in the negotiation. If Party B accepts, each of Party A and Party B sends position data over the network to the central server 120. The data sent by the parties may include, for example, information defining the situation and desired resolutions, but the data is not limited to these types of information. Multiple issues may be presented by both parties in their position data. Based on the data provided, the server generates data characterizing a zone of possible agreements (ZOPA) 130, and the data is rendered as a set of components in a template. The template is provided to each party and shows the nature of the situation as presented by both parties. The template includes components showing possible resolutions to the positions of the parties. The central server process generates these components by accessing a database 140 stored on a digital storage medium in communication with the server. Thus, even though multiple issues are presented in a situation the server process is capable of generating a ZOPA 130 with one or more components with only one access to the database 140. The database 140 may be implemented, for example, as a relational database. The relational database associates the data from each party to components in the database to form the ZOPA template 130. The relational database contains statistical information concerning acceptable resolutions previously agreed to by other parties involved in a similar situation. Each party may then respond to the central server 120 by providing additional data, which may, for example, be entered via a provided ZOPA template. The central server 120 receives the new data, and based on this data creates a new ZOPA template 130 which narrows the issues of the situation. After an iterative process, a resolution is reached or a negotiation log is finalized for presentation to a mediator.

[0043] All data communications between the parties and the central server process, as well as communications between the parties, may be captured and recorded in the negotiation log file 150 by the server 120. The negotiation log 150 is a series of data fields constructed from the parties' answers posed by the server process. In one embodiment the data fields are a collection of structured data forming a database. Various display templates may be created for accessing specific fields and presenting them to the mediator, arbitrator, the parties or a third party. These display templates allow the data fields to be presented using a standard form. Accessing data fields and creating templates is known to those of ordinary skill in the art. The fields in general will be presented in their totality to each requestor, however, the data displayed in the templates may be amended, abbreviated, etc. based upon the requestor. For example expletives and derogatory statements may be removed prior to transmittal to a party. Further, consumer specific information, such as credit card numbers may be absent from a template which is to be viewed by a

mediator or third party. The negotiation log is activated during the intake process and it is attached to a system assigned transaction number. The log is updated continually and remains archived and accessible indefinitely.

Thus, the Examiner asserts that when the merchant sends account data over a network regarding a disputed credit card item corresponding to a purchase transaction occurring with the merchant over the Internet, the account transaction data having been stored in a memory or database of the merchant, to the dispute resolution system wherein the data gets stored in the ZOPA database, then the data is being automatically electronically being communicated between the database of the electronic marketplace and the online dispute resolution system.

As for claim 115, this claim is directed to a system wherein the online dispute resolution system and the marketplace have separate databases, and wherein the online dispute system comprises a data manager software application to automatically communicate data between the database of the online dispute resolutions system and the database of the electronic marketplace. As for the language *to automatically communicate data between the database of the online dispute resolution system and the database of the electronic marketplace,* the Examiner asserts that this intended use language and thus is given little patentable weight since the systems of Collins and Sloo are fully capable of providing communication of data between databases.

Collins discloses preferred embodiments of the invention may be implemented as a computer program product for use with a computer system [0065].

Furthermore, Sloo discloses a method and system wherein the subject (retailer/marketplace) responds to the complaint (the response) by entering information (transaction data) into one of the access terminals by emailing or transmitting the information to the central computer which includes conventional memory (databases) by way of the communication network (col. 6, lines 55-60) (see also column 3, lines 8-17, lines 18-30 *access terminals 14 receive complaints and responses from users, delivers them to the central computer and **receives transmissions from the central computer,** each access terminal includes conventional memory (databases) and software for communicating with and interpreting the data.*

Thus, Sloo discloses communicating data between a complainant and a responder (retailer) with the aid of a computer via an electronic communication network. The Examiner asserts that the fact that the online dispute resolution system and the marketplace have separate databases does not mean that they have to be separate computers. The information, i.e., the complaint and a response (data describing the transaction from the responder) are entered manually via access terminals (14) and then stored in the central computer (12) of the complaint handling apparatus (10) (*online dispute resolution system*) wherein the access terminals include conventional memory (databases) and *software* for communicating with and interpreting the data sent *from* the central computer (*data manager software*).

Furthermore, it is not clear to the Examiner that the Appellant's transaction data was not also manually entered into the computer at some point in time.

The appellant states that the Examiner cites *Collegenet, Inc. v. Applyyourself,
Inc.* (CAFC, 04-1202-1222, 1251, 8/2/2005) wherein the court held that "automatically"
means "without human interaction, but may be human initiated or interrupted." The
Examiner asserts that a process may be automatic even though a human initiates it.
The term "automatic" also covers a human entering data and clicking a button to have
the data electronically communicated.

The appellant states that *Collegenet* cuts entirely against the Examiner's
rejection of claims 111 and 115. Thus, the appellant states that even by the
Examiner's construction of the term "automatically," Sloo in combination with Collins
fails to teach or suggest automatically electronically communicating the transaction
data between the databases of the online dispute resolution system and the databases
of the electronic marketplace. As stated above, the Examiner asserts that when the
merchant sends account data over a network regarding a disputed credit card item
corresponding to a purchase transaction occurring with the merchant over the Internet,
the account transaction data having been stored in a memory or database of the
merchant, the data being sent to the dispute resolution system where the data gets
stored in the ZOPA database, then the data is being automatically electronically being
communicated between the database of the electronic marketplace and the online
dispute resolution system.

Dependent Claims 110 and 113:

The appellant argues that none of the cited prior art, either singularly or in combination, teaches or suggests an online dispute resolution system capable of receiving enrollment requests for the marketplace, let alone initiating enrollment in the online dispute resolution system in response to the request received from the marketplace.

The Examiner respectfully disagrees.

Collins discloses an apparatus and method for facilitating agreement over a network (Figure 1a and page 3 [0037]]) wherein once the steps are taken by the parties in communication with the central processor to begin negotiation, step 300 begins the negotiation initialization state which, the Examiner asserts, might also be called the registration state as it includes identification of relevant parties and a determination of eligibility to participate (page 4 [0046] and Figure 2).

The appellant states that paragraphs [0046] and [0047] describe a negotiation process, and the only portion even relevant to initiating enrollment is step 300. Appellant states that step 300 merely mentions that the relevant parties are identified and their eligibility to participate determined. Thus, the appellant asserts that Collins does not describe any form of "automatic enrollment."

The Examiner, again, directs that appellant to *Collegenet, Inc. v. Applyyourself, Inc.* (CAFC, 04-1202-1222, 1251, 8/2/2005) wherein the court held that "automatically" means "without human interaction, but may be human initiated or interrupted." The Examiner asserts that an enrollment process may be automatic even though a human

initiates it, enters data, and then, by clicking a button, electronically communicates the

data.

Furthermore, the cited portions of Collins disclose:

[0046] Fig. 2 is a flow chart showing the steps taken by parties in communication with a central processor to begin a negotiation. Step 300 begins the negotiation initialization. This stage might also be called the *registration stage,* as it includes identification of relevant parties and determination of eligibility to participate. Following the registration stage, the method proceeds to Step 400 which involves issue definition and clarification. At this stage, the parties define the situation in terms of one or more issues. The issues are defined by the server process which first presents a template containing general issues from a database to the parties. Based on the issues selected by the parties the server process selects narrower issues from the database refining the original issues to more specific issues. The issues are also clarified by the parties to ensure that there is agreement regarding which issues must be resolved in order to reach an agreement. Once the situation has been defined by a set of issues, the parties attempt to resolve each separate issue in the set of issues in Step 500. A zone of possible agreements (ZOPA) for an individual issue serves as a guideline for resolution of that issue. The ZOPA comprises a set of possible resolutions to an issue, each of which may be called a ZOPA component. Each ZOPA component is a general resolution of an issue, which may be further refined by the parties to include details specific to the situation. Resolution of an individual issue results in a tentative agreement contingent on the whole (TACOW). The TACOWs are refined and combined into a total agreement at the Post-Negotiation process 600.

[0047] Referring now to Fig. 3, negotiation initialization begins with Step 310 with a first party being introduced to the system and educated about the use of the system. Introduction and education may, for example, be achieved by displaying one or more screens to the first party. In Step 320, the first party may choose whether or not to participate in a negotiation session. For example, a screen providing the terms of use may be displayed to the first party. If the first party does not agree to the terms of use, the process ends. If the first party agrees to the terms of use, the method proceeds to Step 330 and the first party's position data is obtained. Position data obtained from the first party may, for example, include the first party's identity (name, address, phone # etc.), the identity of a second party with whom a dispute exists, and the date of the dispute, but is not limited to such data. The first party may complete a template that will provide structure to the data supplied by the first party, so that the data may be usefully managed in accordance with the method of the embodiment. The next step is to

determine whether the first party is eligible, in accordance with a set of criteria, to appear in a session with respect to the situation, as shown in Step 340. Eligibility will necessarily depend on the context of use of the method of this embodiment. For example, *if the method is used for dispute resolution in connection with goods sold by a merchant over the Internet,* and the first party has indicated that his dispute is unrelated to a transaction with the merchant, the criteria used in this determination will usefully be structured to render the first party ineligible to appear in the session. Similarly, it may be that the first party has a dispute that arose in connection with such a transaction, but the dispute is not really brought in good faith. For example, a party claims that a product does not perform a task even though the product was never intended for that task. In the event of a negative determination, the result is that a session is not established on the basis of the first party's Position data, and the implicit request to establish the session is declined in Step 345. If there is a determination of eligibility in Step 340, then in accordance with Step 350, a second party is invited to participate in the negotiation. In a preferred embodiment, a Negotiation Log file is created which records the position data obtained from the first party. It should be understood that the Negotiation Log file may be created at any other time following the first party's introduction to the system. In some embodiments, the Negotiation Log file may be provided to a human mediator or arbiter should the parties require live negotiation or arbitration. The second party is provided with the first party's position data which briefly outlines the situation that will be the subject of the negotiation session. The second party is also educated in a method similar to Step 310. At Step 360, the second party decides whether or not to participate as in Step 320. For example, if the second party agrees to the terms of use, the method proceeds to

Step 370 and the second party's position data may be obtained in a method similar to the method of Step 330. The second party's position data is then recorded and added to the Negotiation Log file. If the second party does not agree to participate, the second party's non-agreement is recorded in the Negotiation Log file, and at Step 365 the second party enters into a first recovery stage. The first recovery stage is designed to persuade the second party to participate in a negotiation session.

Moreover, the appellant's enrollment process is disclosed as follows on pages

15 and 16 of the specification:

FIG. 4 is a diagram illustrating a process 240 whereby a seller can request coverage from the dispute resolution system. Upon receipt of a request to initiate coverage, the system of FIG. 1 provides the seller with a welcome page 242 where the seller can enter his or her user identification and password information. If the user is new, the seller can enter a registration page 244 by

clicking on a registration hotlink. Upon completing the registration process, the process of FIG. 4 notifies the seller of a successful registration and displays other relevant information in page 246 before looping back to the start of the process 240.

FIG. 5 shows a buyer registration process 270 for enrolling a buyer with the dispute resolution system of FIG. 1. First, the system provides a registration page 272 that guides the buyer through a registration process. The page 272 requests the user to enter information in an input box 274. The information required includes certain unique user identification information such as his or her electronic mail address, name, credit card type and number, and billing address. Once the dispute being filed passes the pre-screen, the buyer is charged with a filing fee. Additionally, a user agreement is displayed in a scrolling text box 276. The agreement binds the appellant to the online dispute resolution process. The buyer can view this agreement and, if acceptable, click on an acceptance button 278. After the user has filled out all items in the screen 272, the user can then click on a submit button 279 to enroll in the system.

When the submit button 279 is selected, the process then checks whether the buyer is authorized under his or her credit arrangement. If not, the process requests the user to reenter his or her identification information. Alternatively, if the user is authorized, the process updates a membership profile database, notifies the appellant of acceptance, and buyer can proceed to file the dispute. During normal transactions, the buyer can check whether a dispute resolution system logo is shown on the seller's site. If not, the buyer can request the seller to be a member of the dispute resolution system. If the seller agrees to join the dispute resolution system, a registration process is performed. Alternatively, if the seller does not agree to the terms of the dispute resolution system, the buyer makes a decision as to whether he or she is willing to commit to purchasing without the appropriate dispute resolution assurance and either proceeds with the transaction or cancels the transaction.

Thus, it appears that the appellant's enrollment process is much like Collins, wherein a screen is displayed for information to be entered for registering with the system. It appears that appellant's request for enrollment comes from the seller, not the marketplace. Moreover, Collins also discloses pre-registration or enrollment of merchants in paragraph [0053]:

[0053] Referring now to Fig. 9, an alternate embodiment of a method in accordance with the present invention is shown. The method described may be particularly suited, for example, to resolution of a post-transaction dispute between a consumer and a merchant. This is because the method does not require obtaining the second party's consent to participate in the process, as it may be implicitly determined if, for example, the second party is a merchant who has previously agreed to participate in sessions to resolve post-transaction disputes. Furthermore, many post-transaction disputes are similar in nature so that statistical data pertaining to previous resolutions to a similar situation may be particularly useful in aiding in the resolution of the present situation. In Fig. 9, the processes 1000, 1100, 1200, and 1300 roughly correspond to the processes 300, 400, 500, and 600 of Fig. 2.

The appellant states that the parties manually access the Collins dispute handling system and enter information and, thus, the cited section does not describe any form of enrollment request received for communication from an online marketplace. Appellant once again states that the Examiner has again erroneously construed appellant's claims to cover any user manually entering information.

However, it appears that appellant's enrollment process also provides for manual entry of information.

Thus, the Examiner asserts that Sloo in combination with Collins disclose the limitations set forth in dependent claims 110 and 113.

Dependent claims 2, 64 and 93

Claim 2 is directed to the method of claim 1, further comprising automatically selecting one of two modes of resolving the dispute, the first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties in resolving the dispute and the second mode involving a human dispute resolution specialist.

Claim 64 is directed to the system of claim 112, wherein the online dispute

resolution system further comprises:

a database to store facts and outcomes of previously resolved disputes; and

a server that receives case information related to the dispute and compares the

case information to the facts of previously resolved disputes stored by the database to

product a result for use in selection of a mode of resolving the dispute, and presents a

result of comparison to the parties via the network.

Claim 93 is directed to the system of 64, wherein the server compares the case

information to facts of previously resolved disputes to automatically select a resolution

mode comprising one of (i) direct negotiation mode that allows the parties to directly

negotiate a resolution to the dispute via the computer network, (ii) a conciliation mode

that allows the parties to negotiate the resolution to the dispute through a mediator, and

(iii) mediation mode that allows a mediator to propose a resolution to the dispute.

First, the Examiner notes that claims 64 and 93 are directed to a system.

Appellant, again, is trying to define something by what it does rather than what it is.

MPEP 2114 states that while features of an apparatus may be recited either functionally

or structurally, claims directed to an apparatus must be distinguished from the prior art

in terms of structure rather than function. Moreover, intended use limitations are typical

of claim limitations which may not distinguish over the prior art if the structure in the

prior art is capable of performing the intended use.

Appellant states that claim 2 requires automatically selecting one of two modes

of resolving a dispute, the first mode requiring the online dispute resolution process

being driven by an electronic agent to assist the parties in resolving the dispute and the

second mode involving a human dispute resolution specialist.

The Examiner asserts that Sloo discloses a method and system for complaint

handling (*resolving disputes; page 2 lines 54-56*) over a complaint handling apparatus

which includes a computer (Figure 1 and page 3, lines 8-30) wherein there are at least

two modes (Figure 7), the first mode requiring the online dispute resolution process to

be driven by an electronic agent (col. 7, lines 29-40 *Automatic Negotiator which allows*

the apparatus to determine a resolution to the dispute and a second mode involving a

human dispute resolution specialist (Judge/Jury Figure 7 (712)) (the system comprising

a database (*col. 3, lines 8-17; col. 20, lines 25-26 storing means for storing*) and server

that receives information and compares the information to produce a result for use by

the parties in selection of a mode (col. 10, lines 58-66 the program may compare the

current situation with other similar situations having known outcomes and predict the

outcome for the present situation base on these known outcomes. Artificial intelligence

techniques may be used to predict an outcome; col. 11, lines 21-36; col. 20, lines 57-58

comparing means for comparing said data) comprising automatically selecting one of

two modes of resolving the dispute (Figure 7), the first mode requiring the online dispute

resolution process being driven by an electronic agent to assist the parties in resolving

the dispute (Automatic Negotiator (Figure 7 (702) and the second mode involving a

human dispute resolution specialist (Figure 7 (712) Judge/Jury).

Sloo clearly discloses a method and system for complaint handling (resolving

disputes) (Page 2 lines 54-56) over a complaint handling apparatus which includes a

computer (Figure 1 and page 3, lines 8-30) wherein there are at least two modes

(Figure 7), the first mode requiring the online dispute resolution process to be driven by

an Automated Negotiator (electronic agent) which allows the apparatus to determine a

resolution to the dispute and a second mode involving a Judge/Jury (human dispute

resolution specialist).

Appellant states that claim 64 requires a database and a server.   Collins

discloses a database and a server in Figure 1a. The fact that the sever compares facts

to produce a result for use in selection of a mode would be intended use of the system.

Furthermore, Sloo discloses the limitations of claims 2 and 64, as set forth above.

Claim 93 is also directed to a system. Thus, the same arguments as to 64

applies to 93.

Appellant states that the Examiner has failed to address the limitation of claim 64

wherein a server that receives case information related to the dispute and compares the

case information to the facts of previously resolved disputes stored by the database to

product a result for use in selection of a mode of resolving the dispute, and presents a

result of comparison to the parties via the network.

Once again, claim 64 is directed to an apparatus. Secondly, Sloo discloses

comparing facts to previously resolved disputes to produce and display a result for use

by the parties in selection of the resolution mode (column 8, line 50 thru col. 9, line 10;

col. 10, line 54 thru col. 11, line 5; col. 11, lines 27- 36). Thus, Sloo in combination with

Collins disclose this limitation.

Appellant presents arguments as to comments presented by a previous

Examiner in prior previous Office Action dated September 12, 2003. However, the

September 12, 2003 is not the most recent Office Action. The previous Examiner also

provided a rejection on March 12, 2004 and subsequently Appellant filed a Request for

Continued Examination. The most recent amendments and arguments are addressed

in the Office Action dated September 7, 2004. Therefore, the Examiner does not

consider the comments as to the September 12, 2003 Office Action to be relevant.

The Third Ground of Rejection to be Reviewed on Appeal is the rejection of claims 28-31, 114, and 116-117 under 35 U.S.C. 103(a) as being unpatentable over Sloo and Collins as applied to claim 1 and 112 above, and further in view of www.truste.com (retrieved from the Internet Archive Wayback Machine) (hereinafter referred to as TRUSTe).

The appellant's arguments to this ground of rejection are found on pages 36-37.

Appellant argues that claim 30 requires communicating membership data from the

online dispute resolution system to the marketplace (not *online* marketplace as asserted

by appellant) to indicate the availability of the dispute resolution system and the

membership of the buyers and sellers in the dispute resolution process.   Appellant

states on page 27 of the Appeal Brief that:

> As described in the present application, software objects executing within a
> partner system (e.g., the online marketplace 102) provide functionality to receive
> and send specific information to and from the dispute resolution system.4°
> According to the present application, the partner system can query the dispute
> resolution system data to receive status of a particular marketplace seller. *Based
> on the status, the partner system can provide visual indicia that a seller in
> a transaction has membership in the dispute resolution system. Appellant
> further describes how, upon enrolling a seller and updating a membership
> database, a process executing within the dispute resolution system sends
> visual indicia such as a graphical medallion to the online marketplace to be
> displayed by the partner system.*

The Examiner asserts that the appellant is arguing limitations not presented in the claim language.

The Examiner rejected claim 30 as follows:

The limitations of claim 1 are rejected by Sloo in combination with Collins.

TRUSTe discloses communicating membership data from the online dispute resolution to the marketplace (page 32-34 member directory); and

automatically showing a visual indicia within *the marketplace* to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process (pages 14 TRUSTe "trustmark," an online branded seal; 19 and 23 Our "Seal of Trust" and Assurance Process; the site agrees to display the trustmark)

The appellant states that the Examiner entirely overlooks the requirement of communicating membership data from the online dispute resolution system to marketplace. The Examiner asserts that TRUSTe in combination with Sloo and Collins discloses this limitation. Furthermore, appellant is directed to pages 1 and 8 of TRUSTe, wherein the membership database show merchants as being members.

The appellant argues that the Examiner fails to address appellant's claim requirement that the visual indicia is then automatically shown in the marketplace to indicated the availability of the dispute resolution system. Once again, the claim limitations are met when TRUSTe, Sloo and Collins are applied in combination.

It appears that appellant is again arguing that automatically showing a visual indicia means there is no human interaction. The appellant states that to display the

TRUSTe trustmark, the entire process of updating the site must be performed by a user

and no portion of this process is automated based on membership data.   However,

TRUSTe does automatically display a trustmark on licensees Web site (page 23) and

the persons displaying the mark must be members.

The Examiner, again, directs that appellant to *Collegenet, Inc. v. Applyyourself,*

Inc. (CAFC, 04-1202-1222, 1251, 8/2/2005) wherein the court held that "automatically"

means "without human interaction, but may be human initiated or interrupted."

Furthermore, the appellant discloses on page 5 of the specification that:

A visual indicia can be used to indicate membership in the dispute resolution
process. The visual indicia can be a medallion. The system can emulate a court
for on-line transaction parties.

Page 15 of appellant's disclosure discloses:

In all the above cases, if the seller's coverage is successful, the
process updates a membership profile database, notifies the appellant of
acceptance, and sends indicia such as a medallion to be displayed on the
seller's point of sale.

Thus, the Examiner asserts that appellant does not disclose an automated

updating of the site as appellant is now trying to claim the process to be.

**The Fourth Ground of Rejection to Be Reviewed is the rejection of claim
108 under 35 U.S.C. 103(a) as being unpatentable over Sloo in view of Slaikeu (US
Patent 2001/0007106).**

The appellant's arguments as to this ground of rejection are found on pages 37-

38.

Claim 108 is directed to:

The method of claim 1, further comprising:

training a dispute resolution specialist by requiring the dispute resolution specialist to experience transactions within online marketplaces including at least an auction site;

outputting simulated online dispute resolution cases to the dispute resolution specialists via the computer network to assess the skill of the dispute resolution specialists; and

assigning online disputes to the dispute resolution specialists only upon completion of the training and successful resolution of the simulated online dispute resolution cases.

Referring to claim 108, the Examiner rejected the claim as follows:

Sloo discloses intervention by pre-qualified persons (judge/jury)(col. 8, lines 5-18)

The Examiner asserts that Sloo does not a method further comprising:

training a dispute resolution specialist by requiring the dispute resolution specialist to experience transactions within online marketplaces including at least an auction site;

outputting simulated online dispute resolution cases to the dispute resolution specialists via the computer network to assess the skill of the dispute resolution specialists; and

assigning online disputes to the dispute resolution specialists only upon completion of the training and successful resolution of the simulated online dispute resolution cases.

However, the Examiner asserts that Slaikeu discloses a method comprising training a dispute resolution specialist (page 3 [0025- 0026]).

Furthermore, the Examiner takes Official Notice that online training is old and well known and has become an established business practice as is exampled by online CLE classes, online graduate classes and testing. Furthermore, providing simulations of situations is also an old and well known way to train. Thus, the Examiner asserts that it would be an obvious modification to provide dispute training online and to provide simulated situations.

Claim 108 was added in the amendment filed on December 10, 2003. The previous Examiner took Official Notice to the limitations in claim 108 which appellant did not challenge. This Examiner took Official Notice as to Claim 108 in the Office Action mailed on September 7, 2004. The appellant failed to traverse this Official Notice in the Appeal Brief submitted on January 10, 2005 or the Reply Brief submitted on July 7, 2005.

Furthermore, the Examiner asserts that a "traverse" is a denial of an opposing party's allegations of fact.[1] The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art

---

[1] Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

at the time the invention was made. Even if one were to interpret applicants'

arguments and comments as constituting a traverse, applicants' arguments and

comments do not appear to constitute an <u>adequate traverse</u> because appellant has

not specifically pointed out the supposed errors in the examiner's action, which would

include stating why the noticed fact is not considered to be common knowledge or

well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An <u>adequate</u> traverse

must contain adequate information or argument to create on its face a reasonable

doubt regarding the circumstances justifying Examiner's notice of what is well known

to one of ordinary skill in the art. <u>In re Boon</u>, 439 F.2d 724, 728, 169 USPQ 231, 234

(CCPA1971).

The Examiner asserts that since appellant has not seasonably traversed the well

known statement during examination, then the object of the well known statement is

taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA

1943). MPEP 2144.03.

Furthermore, Slaikeu discloses the following:

[0025] Further, the rules require a review of the education and training
process and result in recommendations for implementing training to support the
new organizational conflict handling procedure. Training for the implementation
of the changes to the existing organizational conflict handling procedures
includes an orientation for supervisors and the entire workforce. This training
educates the individuals as to the nature of the program, the benefits of the
program for all employees, and links conflict management to the company's
strategic initiatives.

[0026] Subsequently, **the training element includes training in-house
specialists in the core skills of dispute resolution. This is designed to
equip those who staff the program with the necessary skills to resolve
disputes.** Finally, an essential element of the recommendation is training all

employees and managers for prevention and early intervention in all future conflict situations. As illustrated in FIGS. 1 and 3, early resolution is the starting place of the preferred path for the expert system for the analysis of organizational conflicts handling procedures 10 in every case.

Thus, the Examiner asserts that Slaikeu discloses training a dispute resolution specialists. The Examiner asserts that training by simulating a dispute is old and well known and that most dispute specialist are required to complete some type of training prior to being able to perform such services.

Appellant's 132 Declaration

The appellant addresses the 132 declaration on pages 34-36. The Examiner stated in the Office action mailed September 23, 2005 that the declaration under 37 CFR 1.132 filed June 13, 2003 is insufficient to overcome the rejection of claims 30 and 31 based upon the new grounds of rejection. Appellant now states that the evidence is relevant to claims 1 and 112.

The Examiner maintains that the evidence is insufficient to also overcome the rejections of claims 1 and 112.

As stated in the Office action dated September 23, 2005, upon review of the record it is determined that the previous Examiner did fail to make a written record of consideration of the 132 declaration. However, since the previous Examiner last examined the application, the Appellant has filed a Request for Continued Examination and Appellant's submission filed on April 12, 2004 has been entered. The April 12, 2004 response made no mention of the 132 declaration in the Remarks. Furthermore, since the June 13, 2003 date of the submission of the declaration, the Appellant has

made considerable amendments to claims 30 and 31. Thus, the declaration would not

be relevant to the claim language that is now on appeal. In addition, claim 112 was not

added until the amendment submitted on April 12, 2004.

Moreover, upon reviewing the declarations under 37 CFR 1.132 it is determined

that the declarations are insufficient to overcome the rejection of claims 30 and 31

based upon Sloo and Collins in view of Truste because:

The declarant, Stephen Abernathy, is the CEO of the assignee and thus any

declaration by this person would be considered to be biased since the declarant would

have a financial interest in the grant of a patent on this invention.

The first seven pages of the declaration appear to be merely opinion evidence

and unsupported or uncorroborated allegations.

The Appellant has failed to link the alleged commercial success to the subject

matter in the claimed language. This is especially true as to claims 1 and 112 which

appellant now asserts that the declarations are relevant evidence.

The Appellant has failed to provide any evidence as to the allegation of long felt

need. There is no evidence that a problem existed in the art for a ling period of time

and that the claimed invention solved the problem

The Appellant has failed to provide any objective evidence supporting

patentability of the invention.

It is unclear to the Examiner what the declaration of Ethan Katsh is trying to

establish or what the Appellant is relying on the declaration to prove.
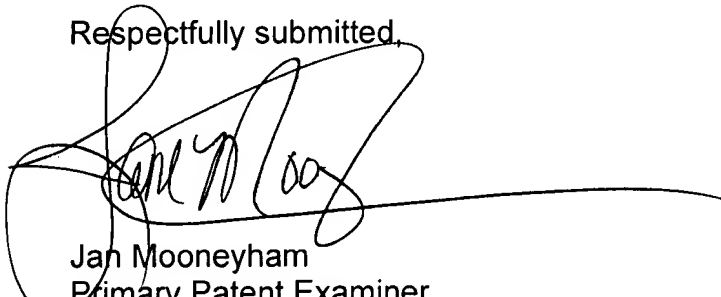
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

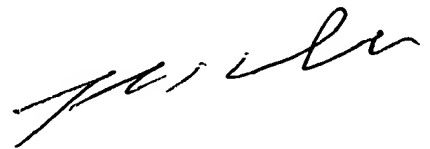For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jan Mooneyham
Primary Patent Examiner
Art Unit 3629

Conferees:

John Weiss, Supervisory Patent Examiner, Art Unit 3629

Dean Nguyen, Primary Patent Examiner, Art Unit 3629